

ESTTA Tracking number: **ESTTA351996**

Filing date: **06/09/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91184456
Party	Plaintiff L'Oreal USA, Inc.
Correspondence Address	Robert L. Sherman Paul, Hastings, Janofsky & Walker LLP 75 East 55th Street New York, NY 10022 UNITED STATES rls@paulhastings.com
Submission	Plaintiff's Notice of Reliance
Filer's Name	Natalie G. Furman
Filer's e-mail	rls@paulhastings.com
Signature	/ngf/
Date	06/09/2010
Attachments	Exhibit D-01.pdf (31 pages)(1269726 bytes) Exhibit D-02.pdf (28 pages)(1664768 bytes) Exhibit D-03.pdf (28 pages)(1897448 bytes) Exhibit D-04.pdf (10 pages)(461650 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/596,736
Published in the Official Gazette on May 6, 2008
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC.,

Opposer,

v.

ROBERT VICTOR MARCON,

Applicant.

Opposition No. 91184456

ORAL ARGUMENT REQUESTED

OPPOSER'S NOTICE OF RELIANCE

(Part 1 continued beginning with Opposer's Exhibit D-1)

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EXHIBIT D-1 TO OPPOSER'S NOTICE OF RELIANCE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Opposer,

v.

ROBERT VICTOR MARCON,

Applicant.

Opposition No. 91184456

OPPOSER'S FIRST SET OF REQUESTS FOR ADMISSIONS

Pursuant to Rule 36 of the Federal Rules of Civil Procedure and 37 C.F.R. 2.120, Opposer L'Oréal S.A. and L'Oréal USA, Inc. (collectively, "L'Oréal" or "Opposer") hereby requests that Applicant Robert Victor Marcon ("Marcon" or "Applicant") respond to the following requests for admissions by serving written responses on the offices of Paul, Hastings, Janofsky & Walker LLP, 75 East 55th Street, New York, NY 10022, within thirty (30) days from the date of service. These requests are continuing and impose upon Applicant the obligations stated in Fed. R. Civ. P. 26, including Applicant's obligation to correct and supplement its responses in a timely manner if Applicant learns that any response is incorrect or incomplete.

For the convenience of the Board and the parties, Opposer requests that each request be quoted in full immediately preceding the response.

DEFINITIONS AND INSTRUCTIONS

1. The terms "Applicant" and "you" refer to Robert Victor Marcon, and Marcon's partners, joint venturers, agents, attorneys, successors-in-interest, predecessors-in-interest, employees and any others acting on behalf of Marcon or over whom Marcon has control.
2. The term "Opposer" or "L'Oréal" shall mean, except where otherwise stated, Opposer L'Oréal S.A. and L'Oréal USA, Inc., L'Oréal S.A.'s and L'Oréal USA, Inc.'s parents, subsidiaries, partners, joint venturers, affiliates, agents, attorneys, successors-in-interest, predecessors-in-interest, employees and any others acting on behalf of L'Oréal S.A. and/or L'Oréal USA, Inc., or over whom L'Oréal S.A. and/or L'Oréal USA, Inc. have control.
3. The term "Applicant's Mark" shall mean the L'ORÉAL PARIS mark that is the subject of U.S. Application Serial No. 76/596,736, and that is the subject of this Opposition proceeding.
4. The term "Applicant's Marks" shall mean any and all marks for which the Applicant has filed applications before the U.S. Patent and Trademark Office, regardless of whether those applications are currently pending, have been registered, or have been abandoned.
5. The term "Opposer's L'ORÉAL PARIS Mark" shall mean L'Oréal's rights in the mark L'ORÉAL PARIS, whether at common law or registered.
6. The term "Opposer's L'ORÉAL Mark" shall mean L'Oréal's rights in the mark L'ORÉAL, including as the subject of U.S. Registration Nos. 661,746 and 540,541, as well as common law rights.
7. The term "document" shall mean, without limitation, every writing or record of every type and description that is or has been in the possession, control or custody of Applicant or of which Applicant has knowledge, whether handwritten, photocopied, telecopied, printed,

electronic or in any other media, including without limitation: correspondence, including e-mail correspondence, invoices, contracts, purchase orders, memoranda, tapes, stenographic or handwritten notes, studies, publications, books, pamphlets, pictures, films, voice recordings, artwork, sketches, drawings, labels, maps, graphs, reports, surveys, minutes, or statistical compilations; every copy of such writing or record where the original is not in the possession, custody or control of Applicant and every copy of every such writing or record where such copy is not an identical copy of an original or where such copy contains any commentary or notation whatsoever that does not appear on the original.

8. The term "date" means the exact day, month and year, if ascertainable; if not ascertainable, the closest approximation that can be made by means of relationship to other events or matters.

9. The term "and" as well as "or" shall be construed both disjunctively and conjunctively, as necessary, to bring within the scope of this request those documents which might otherwise be construed to be outside its scope.

10. Wherever a singular form appears, it also shall be construed as plural, and vice versa, as necessary, to bring within the scope of this request all documents or responses which might otherwise be construed to be outside its scope.

11. The terms "concerning" or "regarding" means reflecting, referring to, incorporating, comprising, touching upon, indicating, evidencing, affirming, denying, or relevant to, in addition to its other customary and usual meaning, and includes, but is not limited to, discussing, constituting, pertaining to, describing, evidencing, identifying, touching upon and/or summarizing.

12. As used herein, "identify" or to "state the identity of" means:

(a) In the case of a person who is an individual: to state the full name, present or last known residence or address (designating which) and present or last known position or business affiliation (designating which); job title; employment address; business and residence telephone numbers of each individual;

(b) In the case of a company, partnership, corporation, proprietorship, association, or other organization or entity, to state: the full name and present or last known address and telephone number; the legal form of such entity or organization; if incorporated; the identity of the person or persons having knowledge of the matter with respect to which the company is named; and the identity of its chief executive officer;

(c) In the case of an act or omission, to state: a description of that act or omission; when it occurred; where it occurred; the identity of the person or persons performing said act (or in the case of an omission, the identity of the person or persons failing to act); the identity of all persons who have knowledge, information or belief about the act or omission; when the act or omission first became known; and the circumstances and manner in which such knowledge was first obtained;

(d) In the case of an oral communication, to state: the date, subject matter, communicator, communicatee, nature of communication, whether it was recorded, and the identity of any witness thereto;

(e) In the case of a document, to state: the identity of the person or persons who prepared it, the sender and recipient, if any; the title or a description of the general nature of its subject; the date of preparation; the date and manner of distribution and publication, if any; the location of each copy and the identity of the present custodian; the identity of the person or

persons who can identify it; the contents of the document verbatim; and if privilege is claimed, the specific basis therefor. In lieu of the foregoing, a copy of the document may be supplied.

13. Each interrogatory or request shall be read to be inclusive rather than exclusive. Accordingly, "including" means "including without limitation." The word "all" includes "any" and vice versa. The past tense includes the present tense and vice versa. The masculine form of any word includes the feminine form and vice versa.

14. Each person responding to interrogatories or requests for admission is required to furnish responsive information within that person's knowledge or the personal knowledge of its, his or her attorneys, agents, employees or other representatives.

15. Each person responding to the document requests is required to furnish responsive documents within that person's possession, custody or control or within the possession, custody or control of its, his or her attorneys, agents, employees or other representatives.

16. Each objection, if any, shall be set forth with specificity and shall include a statement of the grounds for the objection.

17. If any document requested to be identified or produced has been destroyed, provide the following additional information as to each such document:

- (a) the date of destruction;
- (b) the reason for the destruction;
- (c) the identification of the person who destroyed the document; and
- (d) the identification of any person who directed that the document be destroyed.

18. If any of these interrogatories cannot be answered in full, respond to the extent possible, specifying the reasons for the inability to respond to the remainder of the interrogatory, and state whatever information or knowledge is available concerning the unanswered portion.

19. In responding to requests for admissions, if a matter is not admitted, the answer must specifically deny it or state in detail why the answering party cannot truthfully admit or deny it. A denial must fairly respond to the substance of the matter, and when good faith requires that a party qualify an answer or deny only part of the matter, the answer must specify the part admitted and qualify or deny the rest. The answering party may assert lack of knowledge or information as a reason for failing to admit or deny only if the party states that it has made reasonable inquiry and that the information it knows or can readily obtain is insufficient to enable it to admit or deny.

20. If any responsive information, communication or document is withheld on the basis of any claim of privilege, identify such information, communication or document withheld, state the privilege being relied upon or claimed and the basis for the claim, and identify all persons or entities who have had access to such information, communication or document.

21. Applicant must supplement its responses to all discovery requests as required by Fed. R. Civ. P. 26(e).

REQUESTS FOR ADMISSIONS

1. Each document that Applicant has produced or will produce in response to Opposer's discovery requests is genuine and authentic for purposes of admission into evidence during the testimony periods in this opposition proceeding.
2. Opposer's rights in Opposer's L'ORÉAL Mark and in Opposer's L'ORÉAL PARIS Mark predate the filing by Applicant of the subject application for Applicant's Mark.
3. Applicant has not used Applicant's Mark in commerce.
4. Applicant's Mark is identical to Opposer's L'ORÉAL PARIS Mark.
5. The first term in Applicant's Mark is identical to Opposer's L'ORÉAL Mark.
6. The first term in Applicant's Mark is identical to Opposer's trade name.
7. "L'ORÉAL" is the dominant term of the two terms comprising Applicant's Mark.
8. L'Oréal is one of the largest cosmetics and personal care products companies in the world and in the U.S.
9. L'Oréal is one of the best known cosmetics and personal care products companies in the world and in the U.S.
10. L'ORÉAL is one of the best known and widely recognized brands in the world and in the U.S.
11. Opposer's L'ORÉAL Mark is famous.
12. Opposer's L'ORÉAL PARIS Mark is famous.

13. Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark are famous in connection with cosmetics and personal care.

14. Opposer's L'ORÉAL Mark is widely recognized by the general public.

15. Opposer's L'ORÉAL PARIS Mark is widely recognized by the general public.

16. Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark are widely recognized in connection with cosmetics and personal care.

17. The L'Oréal trade name, Opposer's L'ORÉAL Mark, and Opposer's L'ORÉAL PARIS Mark are and for a long time have been widely marketed and promoted to a broad class of consumers through television advertisements, print media, and on the Internet.

18. Products bearing Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark are available through several channels of trade, including but not limited to drug stores, supermarkets, cosmetics stores and beauty care establishments, and on the Internet.

19. Products bearing Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark are available at stores where other personal care goods are sold.

20. Products bearing Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark are available at stores where herbal, mineral, and botanical products (such as vitamins and supplements, health foods, and health drinks) are sold.

21. Applicant was aware of Opposer prior to applying for Applicant's Mark.

22. Applicant was aware of Opposer's L'ORÉAL PARIS Mark prior to applying for federal registration of Applicant's Mark.

23. Applicant was aware of Opposer's L'ORÉAL Mark prior to applying for federal registration of Applicant's Mark.

24. Applicant selected Applicant's Mark at least in part because of the wide-spread recognition of Opposer's L'ORÉAL Mark and/or Opposer's L'ORÉAL PARIS Mark.

25. Applicant selected Applicant's Mark because of the wide-spread recognition of Opposer's L'ORÉAL Mark and/or Opposer's L'ORÉAL PARIS Mark.

26. Applicant has filed several other applications with the U.S. Patent and Trademark Office ("PTO") for marks that he knows are, or he intends to be, identical to previously-registered famous or well-known marks.

27. Applicant filed an intent-to-use trademark application with the PTO for NESTLE for "over the counter medications, namely, analgesics; sleep aids; cold and flu medications" (Application Serial No. 76/596,738).

28. Prior to filing his application to register NESTLE, Applicant was aware of the prior registrations for and/or the extensive trademark use of NESTLE by the owner of that mark in connection with flavored milk and milk-based beverages, water, infant formula, chocolates and candies, ice-cream bars, dietary supplements, and/or bottled water.

29. Applicant filed an intent-to-use trademark application with the PTO for BUDWEISER for various types of beverages, including "water, still water, mineral water, spring water ... sparkling water ... juices, flavored drinks ... non-alcoholic beverages, preparations for making beverages, syrups" (Application Serial No. 78/288,361).

30. Prior to filing his application to register BUDWEISER, Applicant was aware of the prior registrations for and/or the extensive trademark use of BUDWEISER by the owner of that mark in connection with beer, drinking vessels and/or other products.

31. Applicant filed an intent-to-use trademark application with the PTO for EVIAN for "ice cream; sherbet; and frozen confections" (Application Serial No. 76/577,011).

32. Prior to filing his application to register EVIAN, Applicant was aware of the prior registrations for and/or the extensive trademark use of EVIAN by the owner of that mark in connection with, among other things, natural mineral waters; "skin care lotion sold in an atomizer preparation" and various other personal care products including creams, lotions, perfumery, and cosmetics; dietary food supplements; water-based mineral supplements; and a variety of beverages including fruit and vegetable juices, lemonade, ginger beer, and sorbet drinks.

33. Applicant has also filed intent-to-use applications with the PTO for, among other things, HEINEKEN for "meat juices" (Ser. No. 78/288,366); ABSOLUT for various beverages including beer, mineral water, sparkling water, and juices (Ser. No. 78/288,367); FINLANDIA for various beverages including water, juices, and flavored drinks (Ser. No. 78/288,365); COORS for "meat juices, and meat juice concentrates" (Ser. No. 78/288,364); JACK DANIEL'S for "cigars, cigarettes, and chewing tobacco" (Ser. No. 76/596,734); DOM PERIGNON for "meat juices, and broth comprising meat juices" (Ser. No. 78/288,358); BAYER for "non-medicated breath fresheners delivered via aerosol spray; non-medicated mouthwash and gargle" (Ser. No. 76/596,737); NESCAFÉ for "distilled spirits; liqueurs; cordials; and alcoholic coolers, namely; distilled spirit based and malt based" (Ser. No. 76/596,735); and CHANEL for "scented stationery and greeting cards" (Ser. No. 76/596,733).

34. Prior to filing each and every application identified in Request for Admissions No. 33, Applicant was aware of the prior registrations for and/or the extensive trademark use of the subject mark by a large or well-known company, and of the fame or general public recognition of such mark.

35. Applicant's decision to apply for each of Applicant's Marks, including each of the marks identified in Requests for Admissions Nos. 27-33 and Applicant's Mark at issue in this proceeding, was based at least in part on Applicant's awareness of the prior existence of an identical famous or well-known mark.

36. Applicant's decision to apply for each of Applicant's Marks, including each of the marks identified in Requests for Admissions Nos. 27-33 and Applicant's Mark at issue in this proceeding, was based on Applicant's awareness of the prior existence of an identical famous or well-known mark.

37. Applicant did not have a bona fide intent to use each of Applicant's Marks in commerce at the time that he filed an application for each of Applicant's Marks with the PTO.

38. Applicant does not have a bona fide intent to use Applicant's L'ORÉAL PARIS Mark in commerce, and did not have such intent at the time of filing the application that is the subject of this proceeding.

39. Applicant's purpose in applying for Applicant's L'ORÉAL PARIS MARK and/or other of Applicant's Marks is to make a philosophical point about trademark protection.

40. Applicant initially applied to use Applicant's Mark in connection with several products, including perfumes and fragrances; vitamin, mineral and herbal supplements and

combinations thereof; aloe vera drinks; shaving balms, lotions, creams, and soaps; topical skin balms, namely sunscreens, tanning balms, lotions, creams, and combinations thereof; candles; and shaving implements.

41. At the time of filing the application for Applicant's Mark, Applicant was aware that Applicant's Mark as used in connection with perfumes and fragrances; shaving balms, lotions, creams, and soaps; and sunscreens and tanning balms would create a likelihood of confusion with Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark, and specifically that it would create a likelihood of confusion with Opposer's L'ORÉAL mark that is the subject of Registration No. 540,541 for "rouge, face cream, hair lotion, hand cream, eye shadow, face lotion, perfume, cologne, nail polish, suntan oil and face powder."

42. At the time of filing the application for Applicant's Mark, Applicant signed a declaration stating that "to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in identical form thereto or in such new [sic] resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive...."

43. Applicant signed such declaration despite being aware of Opposer's existing registrations for L'ORÉAL and common law use of L'ORÉAL and L'ORÉAL PARIS in connection with cosmetics in general, and specifically despite being aware of Opposer's registration for L'ORÉAL for goods that are identical or very closely related to goods identified in Applicant's application, namely, perfume and cologne, face cream, face lotion, and hand cream; and suntan oil.

44. On or about July 14, 2005, in response to an Office Action that issued from the PTO, Applicant amended his application to (a) state that "the wares or goods herein associated with

the mark 'L'ORÉAL PARIS' will not be manufactured or produced in, or will have any other connection with, the geographic location named in the mark," and (b) cancel all goods other than "aloe vera drinks."

45. Applicant has never manufactured or sold aloe vera drinks.

46. Applicant has no capacity and/or intention to manufacture or sell aloe vera drinks.

47. To the extent that Applicant intends to offer aloe vera drinks under Applicant's Mark, Applicant chose the name L'ORÉAL PARIS because consumers associate that mark with Opposer's L'Oréal name and Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark.

48. To the extent that Applicant intendd to offer aloe vera drinks under Applicant's Mark, Applicant intends to trade on the goodwill and brand awareness developed by L'Oréal in Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark.

49. Aloe vera is an ingredient commonly used in and associated with personal care products, such as but not limited to body lotions, skin creams, after-tanning creams and lotions, hair care products and/or cosmetics.

50. Aloe vera is more commonly associated with skin care products than with beverages.

51. Prior to applying for Applicant's Mark, Applicant was aware that Opposer sells personal care products, including but not limited to skin creams and cosmetics.

52. Prior to applying for Applicant's Mark, Applicant was aware that aloe vera is used in personal care products, including but not limited to skin creams and cosmetics.

53. Prior to applying for Applicant's Mark, Applicant was aware that aloe vera is used in the types of products sold under Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark.

54. Prior to applying for Applicant's Mark, Applicant was aware that L'Oréal uses herbal, mineral, and botanical ingredients in products offered under Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark.

55. Personal care products and herbal, mineral, and botanical products, such as but not limited to herbal supplements or beverages, often emanate from the same source.

56. Personal care products and herbal, mineral, and botanical products, such as but not limited to supplements or beverages, often move through the same channels of trade.

57. Products offered under Opposer's L'ORÉAL Mark and/or Opposer's L'ORÉAL PARIS Mark are sold at stores that also carry herbal, mineral, and botanical products, such as but not limited to supplements or beverages.

58. Drugstores and supermarkets offer both beverages and personal care products such as skin creams.

59. Consumers encountering Applicant's Mark in the marketplace are likely to associate the mark with Opposer, with Opposer's L'ORÉAL PARIS Mark and/or with Opposer's L'ORÉAL Mark.

60. Prior to applying for Applicant's Mark, Applicant was aware that consumers would be likely to believe that aloe vera products offered under Applicant's Mark emanate from the same

source as personal care products offered under Opposer's L'ORÉAL Mark or Opposer's L'ORÉAL PARIS Mark, or are approved by or affiliated with L'Oréal.

61. Applicant is not aware of any other well-known mark utilizing L'ORÉAL.

62. Applicant is not aware of trademark use of the mark L'ORÉAL PARIS by any entity other than L'Oréal.

63. L'Oreal is listed as a surname for fewer than ten individuals or families in the United States, according to a "people search" on the 411.com Internet site.

64. Oreal is listed as a surname for fewer than thirty five (35) individuals or families in the United States, according to a "people search" on the 411.com Internet site.

65. Kodak is a famous trademark.

66. Kodak is listed as a surname for at least 100 individuals or families in the United States, according to a "people search" on the 411.com Internet site.

67. Kodak is a more commonly listed surname than L'Oreal or Oreal in the United States.

68. Buick is a famous trademark.

69. Buick is listed as a surname for approximately 300 individuals or families in the United States, according to a "people search" on the 411.com Internet site.

70. Buick is a more commonly listed surname than L'Oreal or Oreal in the United States.

71. DuPont is a famous trademark.

72. DuPont or Du Pont is listed as a surname hundreds of individuals or families in the United States, according to a "people search" on the 411.com Internet site. According to that site, DuPont or Du Pont is listed as a surname for more than 300 individuals or families in the state of California alone, approximately another 300 individuals or families in the state of Texas alone, and approximately another 300 individuals or families in the state of New York alone.

73. DuPont or Du Pont is a more commonly listed surname than L'Oreal or Oreal in the United States.

74. The word PARIS as used in connection with Applicant's goods is geographically misdescriptive.

Dated: September 29, 2008

Respectfully submitted,

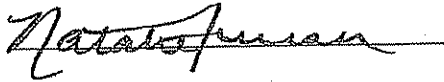
PAUL, HASTINGS, JANOFSKY
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Attorneys for L'Oreal U.S.A., Inc. and L'Oreal S.A.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the OPPOSER'S FIRST SET OF REQUESTS FOR ADMISSIONS has been served upon Robert Victor Marcon, 3471 Sinnicks Avenue, Niagara Falls, Ontario, CANADA, by depositing a true copy of the same with UPS, postage prepaid, on September 29, 2008.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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ROBERT VICTOR MARCON,

Applicant.

Opposition No. 91184456

OPPOSER'S FIRST SET OF INTERROGATORIES

Pursuant to Rule 33 of the Federal Rules of Civil Procedure and 37 C.F.R. 2.120, Opposer L'Oréal S.A. and L'Oréal USA, Inc. (collectively, "L'Oréal" or "Opposer") hereby requests that Applicant Robert Victor Marcon ("Marcon" or "Applicant") answer the following interrogatories, in writing and under oath, by serving written responses on the offices of Paul, Hastings, Janofsky & Walker LLP, 75 East 55th Street, New York, NY 10022, within thirty (30) days from the date of service. These interrogatories are continuing and impose upon Applicant the obligations stated in Fed. R. Civ. P. 26, including Applicant's obligation to correct and supplement its responses in a timely manner if Applicant learns that any response is incorrect or incomplete.

For the convenience of the Board and the parties, Opposer requests that each request be quoted in full immediately preceding the response.

DEFINITIONS AND INSTRUCTIONS

The Definitions and Instructions contained in Applicant's First Set Of Requests for Admissions served herewith are incorporated by reference and shall apply to these requests.

INTERROGATORIES

1. State the date of and describe the reasons for the selection of Applicant's Mark, including the consideration of any other marks and/or any other goods or services, and identify the person(s) with the most knowledge of the selection of Applicant's Mark and goods.
2. State the date and describe the circumstances under which Applicant first became aware of Opposer, of Opposer's L'ORÉAL Mark and of Opposer's L'ORÉAL PARIS Mark, and identify the person most knowledgeable of the foregoing.
3. Identify all investigations, surveys, research, polls, focus groups, or opinions that Applicant has ever conducted, received, or seen concerning confusion or the likelihood of confusion between Applicant's Mark and Opposer's L'ORÉAL Mark or Opposer's L'OREAL PARIS Mark, between Applicant and Opposer, and/or between Applicant's products and Opposer's products.
4. Identify all investigations, research, searches, studies, focus groups, and polls that Applicant has ever conducted, received, or seen concerning the availability for use and/or registration of Applicant's Mark or variations thereof.
5. State all facts that support and evidence Applicant's alleged bona fide intent to use Applicant's Mark in commerce on or in connection with aloe vera drinks as of the filing date of Application Serial No. 76/596,736 and continuing to date.
6. State the actual or intended date of first use anywhere and date of first use in the United States commerce of Applicant's Mark in connection with aloe vera drinks.

7. Describe the types or classes of purchasers to whom Applicant has marketed or intends to market aloe vera drinks in connection with Applicant's Mark.
8. Describe the channels of trade through which Applicant has marketed or intends to market aloe vera drinks in connection with Applicant's Mark.
9. Identify all third parties of which Applicant is aware that advertise, promote, offer or sell both personal care products and herbal, mineral, or botanical products, such as but not limited to supplements or beverages.
10. Identify the persons most familiar with Applicant's Mark, Applicant's aloe vera products, Applicant's actual or intended advertising, promotion, and marketing of aloe vera drinks in connection with Applicant's Mark, and Applicant's actual or intended channels of trade and class of consumers for aloe vera drinks.
11. Identify and describe all agreements between Applicant and any third party concerning the use and/or registration of Applicant's Mark (or any feature, portion, part, element, or component of Applicant's Mark), including but not limited to, license agreements, consent agreements, coexistence agreements, assignments, and settlement agreements.
12. Identify all of Applicant's related companies, including predecessors-in-interest, successors-in-interest, parent, subsidiary, and sister corporations, or other persons and state whether any of them intends to use Applicant's Mark, or intends to manufacture, distribute, or sell any products in connection with Applicant's Mark.

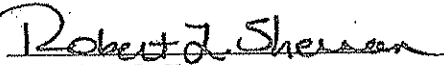
13. Identify each expert witness from whom Applicant intends to introduce testimony during its testimony period in this proceeding and provide the information required in Fed. R. Civ.

P. 26(a)(2)(B)

Dated: September 29, 2008

Respectfully submitted,

PAUL, HASTINGS, JANOFSKY
& WALKER LLP

By: 

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Attorneys for L'Oreal U.S.A., Inc. and L'Oreal S.A.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the OPPOSER'S FIRST SET OF INTERROGATORIES has been served upon Robert Victor Marcon, 3471 Sinnicks Avenue, Niagara Falls, Ontario, CANADA, by depositing a true copy of the same with UPS, postage prepaid, on September 29, 2008.

Handwritten signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/596,736
Published in the Official Gazette on May 6, 2008
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC.,

Opposer,

v.

ROBERT VICTOR MARCON,

Applicant.

Opposition No. 91184456

OPPOSER'S FIRST SET OF DOCUMENT REQUESTS

Pursuant to Rule 34 of the Federal Rules of Civil Procedure and 37 C.F.R. 2.120, Opposer L'Oréal S.A. and L'Oréal USA, Inc. (collectively, "L'Oréal" or "Opposer") hereby requests that Applicant Robert Victor Marcon ("Marcon" or "Applicant") produce the documents and things requested below for inspection and copying to L'Oréal at the offices of Paul, Hastings, Janofsky & Walker LLP, 75 East 55th Street, New York, NY 10022, or at such other place as agreed to by the parties within thirty (30) days from the date of service. These document requests are continuing and impose upon Applicant the obligations stated in Fed. R. Civ. P. 26, including Applicant's obligation to supplement documents in a timely manner if Applicant discovers that its production is incomplete.

For the convenience of the Board and the parties, Opposer requests that each request be quoted in full immediately preceding the response.

DEFINITIONS AND INSTRUCTIONS

The Definitions and Instructions contained in Applicant's First Set Of Requests for Admissions served herewith are incorporated by reference and shall apply to these requests.

REQUESTS FOR DOCUMENTS AND THINGS

REQUEST NO. 1:

All documents and tangible things identified or requested to be identified or comprising the information used, referenced or otherwise incorporated in response to Opposer's First Set Of Interrogatories.

REQUEST NO. 2:

All documents referring or relating to Applicant's consideration of marks and selection and clearance of Applicant's Mark, including but not limited to, searches, investigations, surveys, studies, research, polls, reports and opinions that Applicant has ever conducted, received, or seen concerning the availability for use and/or registration of L'ORÉAL PARIS or variations thereof.

REQUEST NO. 3:

All documents referring or relating to Applicant's consideration of goods or services to be offered in connection with the L'ORÉAL PARIS Mark, including but not limited to, searches, investigations, surveys, studies, research, polls, reports and opinions.

REQUEST NO. 4:

All documents evidencing Applicant's bona fide intent to use Applicant's Mark in the United States on or in connection with aloe vera drinks.

REQUEST NO. 5:

All market surveys, studies or other reports concerning U.S. consumers of products intended to be sold in connection with Applicant's Mark.

REQUEST NO. 6:

Documents sufficient to identify the classes or types of consumers of products intended to be offered, sold, advertised and/or promoted in connection with Applicant's Mark.

REQUEST NO. 7:

Documents sufficient to identify the channels of trade for products intended to be offered, sold, advertised and/or promoted in connection with Applicant's Mark.

REQUEST NO. 8:

Documents sufficient to identify all retail locations, including but not limited to drug stores, salons, and supermarkets, where Applicant intends to offer, sell, advertise, or promote products in connection with Applicant's Mark.

REQUEST NO. 9:

Documents sufficient to identify all types of media (including but not limited to newspapers, magazines, trade journals, direct mail advertising, radio, television, and the Internet) in which Applicant intends to advertise, promote, offer, feature, display, or sell aloe vera drinks under Applicant's Mark.

REQUEST NO. 10:

Documents sufficient to show all forms and all manners of appearance in which Applicant has depicted, displayed, and/or used, or intends to depict, display and/or use Applicant's Mark, including but not limited to all designs, logos, and stylizations.

REQUEST NO. 11:

Documents showing, referring or relating to all third parties of which Applicant is aware that advertise, promote, offer, or sell both cosmetics or personal care goods and herbal, botanical, or mineral products.

REQUEST NO. 12:

All documents referring or relating to the date when and circumstances under which Applicant first became aware of Opposer and Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark.

REQUEST NO. 13:

All documents comprising, referring, or relating to investigations, surveys, research, polls, focus groups, or opinions that Applicant has ever conducted, received, or seen concerning confusion or the likelihood of confusion between Applicant's Mark and Opposer's L'ORÉAL PARIS Mark or Opposer's L'ORÉAL Mark, between Applicant and Opposer, and/or between Applicant's products and Opposer's products.

REQUEST NO. 14:

All documents comprising, referring, or relating to investigations, surveys, research, polls, focus groups, or opinions that Applicant has ever conducted, received, or seen concerning dilution or the likelihood of dilution of Opposer's L'ORÉAL Mark or Opposer's L'ORÉAL PARIS Mark due to Applicant's use or intended use of Applicant's Mark.

REQUEST NO. 15:

All documents comprising, referring, or relating to investigations, surveys, research, polls, focus groups, or opinions concerning the level of fame or recognition of L'Oréal's trade name or

Opposer's L'ORÉAL Mark or Opposer's L'ORÉAL PARIS Mark, or any other mark associated with L'Oréal.

REQUEST NO. 16:

All documents comprising, referring, or relating to communications, inquiries, or comments to or from any person referring or relating to Opposer or Opposer's L'ORÉAL Mark or Opposer's L'ORÉAL PARIS Mark.

REQUEST NO. 17:

Documents referring or relating to judicial and/or administrative proceedings in any forum referring or relating to Applicant's Mark or any portion, part, feature, element, or component of Applicant's Mark.

REQUEST NO. 18:

Documents sufficient to identify all names and marks comprised of or containing a mark previously-registered or widely used by another that Applicant has registered, currently uses, intends to use, or has sought to register as a trademark, service mark, or domain name.

REQUEST NO. 19:

Documents comprising, referring, or relating to agreements between Applicant and any third party concerning the use and/or registration of Applicant's Mark, including but not limited to, license agreements, consent agreements, coexistences agreements, assignments, and settlement agreements.

REQUEST NO. 20:

Documents sufficient to identify any and all of Applicant's related companies, including predecessors-in-interest, successors-in-interest, parent, subsidiary, and sister corporations, and sufficient to indicate whether any of those related companies uses Applicant's Mark.

REQUEST NO. 21:

All documents referring or relating to each expert witness from whom Applicant intends to introduce testimony during its testimony period in this proceeding, and all documents pertaining to the information required to be disclosed under Fed. R. Civ. P. 26(a)(2)(B), including all communications to or from the expert witness and all final and draft reports prepared by or for the expert witness.

REQUEST NO. 22:

All documents relating to the term L'ORÉAL or L'ORÉAL PARIS or to Opposer L'Oréal not produced in response to any of Opposer's other requests for documents and things.

REQUEST NO. 23:

A copy of the complete file history of Application Serial No. 76/596,736.

REQUEST NO. 24:

A copy of the complete file history of Applicant's Canadian application and opposition proceeding regarding Applicant's Mark.

Dated: September 29, 2008

Respectfully submitted,

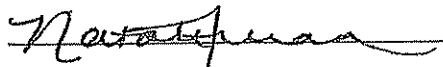
PAUL, HASTINGS, JANOFSKY
& WALKER LLP

By: Robert L. Sherman
Robert L. Sherman
Natalie G. Furman
75 East 55th Street
New York, NY 10022
(212) 318-6000

Attorneys for L'Oreal U.S.A., Inc. and L'Oreal S.A.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the OPPOSER'S FIRST SET OF DOCUMENT REQUESTS has been served upon Robert Victor Marcon, 3471 Sinnicks Avenue, Niagara Falls, Ontario, CANADA, by depositing a true copy of the same with UPS, postage prepaid, on September 29, 2008.

A handwritten signature in cursive script, appearing to read "Notariffina", with a long horizontal flourish extending to the right.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/596,736
Published in the Official Gazette on May 6, 2008
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC.,

Opposer,

v.

ROBERT VICTOR MARCON,

Applicant.

Opposition No. 91184456

ORAL ARGUMENT REQUESTED

EXHIBIT D-2 TO OPPOSER'S NOTICE OF RELIANCE

1 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
2 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**
3 **(TRANSMITTAL INFORMATION AND MAILING CERTIFICATION)**
4

5 **Opposition No.:** 91184456
6 **TRADEMARK:** L'OREAL PARIS
7 **Application Serial No.:** 76596736
8 **Applicant(s):** Robert Victor Marcon
9 **Opposer(s):** L'Oreal USA, Inc. and L'Oreal S.A.
10 **Opposer(s) Attorney:** Robert L. Sherman
11 **Reply Number:** Communication - B
12 **Number of Pages:** Two hundred and six (206)
13
14

15 **CERTIFICATE OF MAILING**

16 I hereby certify that this correspondence is being deposited with the U.S. Postal Service
17 as EXPRESS MAIL in an envelope addressed to, "U.S. Patent and Trademark Office,
18 Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA, U.S.A., 22313-1451".
19

20 **Express Mail Serial No.:** EB 182588915 US
21 **Date of Deposit:** 30 October 2008
22
23 **Depositor's Signature:** Robert Marcon (Robert Marcon)
24
25

26 **CERTIFICATE OF SERVICE**

27 I hereby certify that a true and complete copy of the foregoing correspondence has been
28 served on the Opposers' representative "ROBERT L. SHERMAN" by mailing said copy via
29 U.S. Postal Service EXPRESS MAIL to "Robert L. Sherman, Paul, Hastings, Janofsky &
30 Walker LLP, 75 East 55th Street, New York, NY, U.S.A., 10022".
31

32 **Express Mail Serial No.:** EQ 678050187 US
33 **Date of Deposit:** 30 October 2008
34
35 **Depositor's Signature:** Robert Marcon (Robert Marcon)

CASE PARTICULARS

APPLICANT INFORMATION

Name of Applicant: Robert Victor Marcon
Mailing Address: Street: 3471 Sinnicks Avenue
City/Province: Niagara Falls, Ontario
Country: Canada
Zip Code: L2J 2G6
Other Communications: Telephone: (905) 354-2543

OPPOSERS' INFORMATION

First Opposer: L'Oreal USA, Inc.
Mailing Address: 575 Fifth Ave., New York, NY, U.S.A., 10017
Other Communications: Unknown

Second Opposer: L'Oreal S.A.
Mailing Address: L'Oreal S.A., 14 rue Royale, Paris, France, 75008
Other Communications: Unknown

Opposers' Attorney: Robert L. Sherman,
Paul, Hastings, Janofsky & Walker LLP
Mailing Address: Street: 75 East 55th Street
City/State: New York, New York
Country: U.S.A.
Zip Code: 10022
Other Communications: Telephone: (212) 318-6000
e-mail: rls@paulhastings.com

IN THE MATTER OF an Opposition by
L'Oreal USA, Inc. and L'Oreal S.A.
to Application Serial No. 76/596,736 filed by
Robert Victor Marcon
for the trademark "L'OREAL PARIS"
(Opposition No. 91184456)

COMMUNICATION - B
RESPONSE TO OPPOSERS' REQUESTS

This is a response to the letter mailed (September 29, 2008) by the Opposers' Attorney, namely, Robert L. Sherman of Paul, Hastings, Janofsky & Walker LLP to the Applicant herein, namely, Robert Victor Marcon. Said letter consists of three (3) requests which include:

- (1) Opposer's First Set of Requests for Admissions (1-74);
- (2) Opposer's First Set of Interrogatories (1-13); and
- (3) Opposer's First Set of Document Requests (1-24).

Therefore, in accordance with current trademark protocols and procedures the Applicant will provide the requested information to the Opposers' Attorney and the U.S. Patent and Trademark Office, Trademark Trial and Appeal Board. Note also, that the Applicant will respond to each request made by the Opposers' Attorney in the same sequence and order as was presented in his letter thereby avoiding unnecessary paperwork and duplication (a copy of the Attorney's letter is also include as reference).

Included in this communication are the following five (5) items totalling two hundred and sixty-eight (268) pages:

- (1) Applicant's response to the Opposer's First Set of Requests for Admissions

Opposition No. 91184456; Mark: L'OREAL PARIS; Appl. No. 76596736; Comm-B

(1-74);

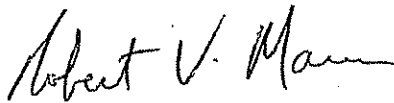
(2) Applicant's response to the Opposer's First Set of Interrogatories (1-13);

(3) Applicant's response to the Opposer's First Set of Document Requests (1-24);

(4) A copy of the aforesaid Attorney letter mailed September 29, 2008; and

(5) Applicant's Notice of Reliance (Applicant's Evidence).

Respectfully submitted,



Robert V. Marcon,

Applicant Pro Se

30 October 2008

Opposer's First Set of Requests for Admissions (1-74)

1. The Applicant acknowledges said statement.

2. The Applicant disagrees with said claim.

First, the USPTO trademark database shows that the Opposers do not own or control any "LIVE" trademarks consisting of the words "L'OREAL PARIS".

Second, trademarks must be considered in their entirety and not as dissected items. The Opposer other marks do not consist of the words "L'OREAL PARIS".

Third, the fundamental concept of a trade-mark being granted in relation to certain wares would be rendered meaningless if the wares were not taken into account. The Opposer's wares are not even remotely similar to the Applicant's sole remaining ware.

Consequently, the Applicant thereby concludes that the Opposers' rights do not predate those of the Applicant.

3. The Applicant acknowledges said statement.

4. The Applicant disagrees with said claim. According to the USPTO database the Opposers do not own or control any "LIVE" trademarks consisting of the words "L'OREAL PARIS".

5. The Applicant acknowledges said statement.

6. The Applicant acknowledges said statement.

7. Applicant disagrees with said statement.

8. The Applicant is without knowledge or information sufficient to form a belief as

to the validity of the Opposers' statement.

9. The Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

10. The Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

11. The Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

12. The Applicant disagrees with said claim. According to the USPTO trademark database the Opposers do not own or control any "LIVE" trademarks consisting of the words "L'OREAL PARIS". As may regard any common law or any other rights claimed by the Opposer -- the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

13. The Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

14. The Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

15. The Applicant disagrees with said claim. According to the USPTO trademark database the Opposers do not own or control any "LIVE" trademarks consisting of the words "L'OREAL PARIS". As may regard any common law or any other rights claimed by the Opposer -- the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

16. The Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

17. The Applicant is without knowledge or information sufficient to form a belief as

to the validity of the Opposer's statement.

18. In regards to the mark "L'OREAL PARIS" -- the Opposers do not own or control any live marks consisting of the words "L'OREAL PARIS" according to the USPTO trademark database. As such, the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposer's statement.

In regards to the mark "L'OREAL" -- the Applicant has seen various products bearing the mark "L'OREAL" in drug stores and supermarkets. However, this is not an unusual situation for drug stores, supermarkets, and large big box stores normally sell tens of thousands of different products from a multitude of different companies some of which employ identical marks for similar wares.

19. In regards to the mark "L'OREAL PARIS" -- the Opposers do not own or control any live marks consisting of the words "L'OREAL PARIS" according to the USPTO trademark database. As such, the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposer's statement.

In regards to the mark "L'OREAL" -- the Applicant has seen other personal care products sold in the same stores. However, this is not an unusual situation for large retail stores normally sell tens of thousands of different products from a multitude of different companies some of which employ identical marks for similar wares.

20. In regards to the mark "L'OREAL PARIS" -- the Opposers do not own or control any live marks consisting of the words "L'OREAL PARIS" according to the USPTO trademark database. As such, the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

In regards to the mark "L'OREAL" -- the Applicant has seen other said products sold in the same stores. However, this is not an unusual situation for large stores normally sell tens of thousands of different products from a multitude of different companies some of which employ identical marks for similar wares.

34 21. The Applicant acknowledges said statement.

35
36 22. According to the USPTO database the Opposers do not own or control any "LIVE"
37 trademarks consisting of the words "L'OREAL PARIS". Applicant, however, was
38 aware of previous "DEAD" marks consisting of the words "L'OREAL PARIS" which
39 belonged to the Opposers.

40
41 23. The Applicant acknowledges said statement.

42
43 24. The Applicant disagrees with said statement.

44
45 25. The Applicant disagrees with said statement.

46
47 26. The question is irrelevant and immaterial in that it does not deal with the subject
48 matter at hand. That is because what is important and cardinal in these
49 opposition proceedings is not whether the Applicant's other applications should
50 or should not be allowed but whether or not the Applicant's mark "L'OREAL
51 PARIS" should or should not be allowed. Superfluous references to unrelated and
52 independent trade-marks applications which have no bearing on this case serve
53 only to cloud the important issues which are truly relevant. Consequently, such
54 questions being irrelevant and immaterial need not be answered.

55
56 27. The question is irrelevant and immaterial in that it does not deal with the subject
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294 opposition proceedings is not whether the Applicant's other applications should
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298 only to cloud the important issues which are truly relevant. Consequently, such
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00 32. The question is irrelevant and immaterial in that it does not deal with the subject
01 matter at hand. That is because what is important and cardinal in these
02 opposition proceedings is not whether the Applicant's other applications should
03 or should not be allowed but whether or not the Applicant's mark "L'OREAL
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05 independent trade-marks applications which have no bearing on this case serve
06 only to cloud the important issues which are truly relevant. Consequently, such
07 questions being irrelevant and immaterial need not be answered.
08

09 33. The question is irrelevant and immaterial in that it does not deal with the subject
10 matter at hand. That is because what is important and cardinal in these
11 opposition proceedings is not whether the Applicant's other applications should
12 or should not be allowed but whether or not the Applicant's mark "L'OREAL
13 PARIS" should or should not be allowed. Superfluous references to unrelated and
14 independent trade-marks applications which have no bearing on this case serve
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16 questions being irrelevant and immaterial need not be answered.
17

18 34. The question is irrelevant and immaterial in that it does not deal with the subject
19 matter at hand. That is because what is important and cardinal in these
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22 PARIS" should or should not be allowed. Superfluous references to unrelated and
23 independent trade-marks applications which have no bearing on this case serve
24 only to cloud the important issues which are truly relevant. Consequently, such
25 questions being irrelevant and immaterial need not be answered.
26

27 35. The question is irrelevant and immaterial in that it does not deal with the subject
28 matter at hand. That is because what is important and cardinal in these
29 opposition proceedings is not whether the Applicant's other applications should
30 or should not be allowed but whether or not the Applicant's mark "L'OREAL
31 PARIS" should or should not be allowed. Superfluous references to unrelated and
32 independent trade-marks applications which have no bearing on this case serve

only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

36. The question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Such questions being irrelevant and immaterial need not be answered.

In regards to the Applicant's application for the mark "L'OREAL PARIS" the Applicant disagrees with the Opposers. Moreover, the Opposers do not own or control any "LIVE" trademarks consisting of the words "L'OREAL PARIS" according to the USPTO database.

37. The Applicant disagrees with the Opposers. The Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce.

As for the Applicant's other applications -- the question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

38. The Applicant disagrees with the Opposers. The Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce.

As for the Applicant's other applications -- the question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

39. The Applicant disagrees with the Opposers. The Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce and not to make a philosophical point about trademark protection.

As for the Applicant's other applications -- the question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

40. The Applicant acknowledges said statement.

41. The Applicant acknowledges the wares so named therein.

The Applicant, however, disagrees with the Opposers in that the Applicant did not believe that confusion would occur between the Applicant's mark "L'OREAL PARIS" and those of the Opposers since the USPTO trademark database had not revealed any conflicting wares with the Applicant's mark "L'OREAL PARIS".

399 In addition, according to the USPTO database the Opposers do not own or control
400 any "LIVE" trademarks consisting of the words "L'OREAL PARIS".
401

402 42. The Applicant acknowledges said statement.
403

404 43. The Applicant, however, disagrees with the Opposers in that the Applicant did
405 not believe that confusion would occur between the Applicant's mark "L'OREAL
406 PARIS" and those of the Opposers since the USPTO trademark database had not
407 revealed any conflicting wares with the Applicant's mark "L'OREAL PARIS".
408

409 Second, according to the USPTO database the Opposers do not own or control any
410 "LIVE" trademarks consisting of the words "L'OREAL PARIS".
411

412 Third, it should be realized that when determining prospective confusion between
413 trademarks the trademarks must be considered in their entirety and not as
414 dissected items. The Opposers' marks do not consist solely of the words
415 "L'OREAL PARIS" and the Opposers' marks "L'OREAL" do not include the word
416 "PARIS" in their constituencies.
417

418 Fourth, the fundamental concept of a trademark being granted in relation to
419 certain wares would be rendered meaningless if the nature of wares were not
420 taken into account. This concept is born out by the very fact that the USPTO
421 trademark database contains many identical trademarks that have been and
422 continue to be allowed because they list wares sufficiently different to overt
423 confusion. The Applicant's "L'OREAL PARIS" mark would be no different.
424

425 Fifth, the purpose of the U.S. Patent and Trademark Office, as well as any other
426 similar office, is to safeguard existing trademarks. As such, all applications are
427 thoroughly examined and reviewed for that purpose. Thus, if an application is
428 flawed or the applicant erred, in any manner, those errors will be corrected
429 accordingly in a manner specified by the rules and regulation currently existing.
430 No trademark application will be permitted to be approved if it has not met all the
431 legal requirements stipulated in law.

Thus, the Applicant, in prosecuting his application, has deleted or otherwise removed all wares but one. That one remaining ware is "aloe vera drinks". Thus, what is truly in dispute is not the Applicant deleted wares but is sole remaining wares or "aloe vera drinks". With this in mind, the Applicant suggest that the Opposers' Attorney focus on said remaining ware and not upon wares long since cancelled.

44. The Applicant acknowledges said statement.

45. The Applicant acknowledges said statement.

46. The Applicant disagrees with the Opposers. The Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce. In todays business world the capacity to manufacture, distribute and sell does not always rest on a persons actual physical facilities. Such things can be rented, joint ventured or procured via outsourcing. Moreover, licensing is also a practical means of business and just as viable a means of business as creating such companies from scratch.

47. Applicant disagrees with the Opposers' statement. The Opposers' marks have never been associated, even remotely, with "aloe vera drinks".

48. Applicant disagrees with the Opposers' statement.

Second, according to the USPTO database the Opposers do not own or control any "LIVE" trademarks consisting of the words "L'OREAL PARIS".

Third, it should be realized that when determining prospective confusion between trademarks the trademarks must be considered in their entirety and not as dissected items. The Opposers' marks do not consist solely of the words "L'OREAL PARIS" and the Opposers' marks "L'OREAL" do not include the word "PARIS" in their constituencies.

Fourth, the fundamental concept of a trademark being granted in relation to certain wares would be rendered meaningless if the nature of wares were not taken into account. This concept is born out by the very fact that the USPTO trademark database contains many identical trademarks that have been and continue to be allowed because they list wares sufficiently different to overt confusion. The Applicant's mark "L'OREAL PARIS" would be no different.

49. The Applicant acknowledges said statement. However, the Opposers, while they may present wares whose compositions contain aloe vera, such examples would be very poor at best for the simple reason that any mark is only associated with the final product itself and not the individual ingredients or constituents that make up those products. After all, products such as milk may contain vitamin D, orange juice may be supplemented with calcium, and cereal fortified with multiple vitamins. Many other unrelated products also employ vitamins, minerals and even herbs but it would be clearly unreasonable to conclude that L'OREAL would also be associated with milk, juice, cereal or even herbs just because some of their cosmetics, skin creams or lotions contained traces of milk, vitamins, minerals or herbs. After all, a person seeking hair dye, cosmetics or skin cream does not contemplate nor go looking for aloe vera drinks (and vice versa). This same analogy also applies to all of the wares evidenced in these opposition proceedings be they the Opposers' or that of others. That is, the final wares themselves are what may or may not be found confusing and not the individual ingredients composing or constituting those wares.

50. Applicant disagrees with the Opposers' statement. In today's business environment beverages containing aloe vera are not uncommon. As to which is the dominant sector, the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

51. Applicant acknowledges the Opposers' statement as it regards the Opposers' "L'OREAL" marks only.

52. Applicant acknowledges the Opposers' statement.

53. Applicant acknowledges the Opposers' statement.

54. Applicant acknowledges the Opposers' statement.

55. The Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

56. The term "often" is open ended. As far as the Applicant is aware personal care products such as hair dye, cosmetics, and skin creams are not sold through restaurants, clubs, and bars thereby demonstrating that the channels of trade of different. As such, the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement in regards to all channels of trade.

57. The only remaining ware left to the Applicant is "Aloe Vera Drinks". The Applicant is aware of such products being sold in some establishments that also sell wares under the Opposers' marks and some establishments like restaurants, clubs, and bars that do not. However, the Opposers, while they may present wares whose compositions contain aloe vera, such examples would be very poor at best for the simple reason that any mark is only associated with the final product itself and not the individual ingredients or constituents that make up those products. After all, products such as milk may contain vitamin D, orange juice may be supplemented with calcium, and cereal fortified with multiple vitamins. Many other unrelated products also employ vitamins, minerals and even herbs but it would be clearly unreasonable to conclude that L'OREAL would also be associated with milk, juice, cereal or even herbs just because some of their cosmetics, skin creams or lotions contained traces of milk, vitamins, minerals or herbs. After all, a person seeking hair dye, cosmetics or skin cream does not contemplate nor go looking for aloe vera drinks (and vice versa). This same analogy also applies to all of the wares evidenced in these opposition proceedings be they the Opposers' or that of others. That is, the final wares themselves are what may or may not be found confusing and not the individual ingredients composing or constituting those wares.

- 531 Moreover, it is not an unusual situation for drug stores, supermarkets, and large
532 big box stores to sell tens of thousands of different products from a multitude of
533 different companies some of which employ identical marks for similar wares.
534
- 535 58. Applicant acknowledges said statement.
536
- 537 59. Applicant disagrees with said statement.
538
- 539 60. Applicant disagrees with said statement.
540
- 541 61. Applicant acknowledges said statement.
542
- 543 62. Applicant disagrees with said statement because the Opposers do not own or
544 control any live marks consisting of the words "L'OREAL PARIS" according to the
545 USPTO trademark database.
546
- 547 63. The Applicant acknowledges said statement. However, the Applicant has
548 provide further information in regards to the name "L'Oreal" in his "NOTICE OF
549 RELIANCE (APPLICANT'S EVIDENCE)" also submitted herein. Second, a better
550 result would have been garnered if something like "LEXIS NEXIS" were used.
551
- 552 64. The Applicant acknowledges said statement. However, the Applicant has
553 provide further information in regards to the name "Oreal" in his "NOTICE OF
554 RELIANCE (APPLICANT'S EVIDENCE)" also submitted herein. Second, a better
555 result would have been garnered if something like "LEXIS NEXIS" were used.
556
- 557 65. The Applicant is without knowledge or information sufficient to form a belief as
558 to the validity of the Opposers' statement.
559
- 560 66. The Applicant acknowledges said statement.
561
- 562 67. The Applicant disagrees with said statement in that the name "L'Oreal" and
563 "Oreal" mean the same thing. That is, in the French language L'Oreal means "The

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Oreal" and "Oreal" remains "Oreal". As such, if one considers this fact then the name "Oreal" is more common (see Applicant "NOTICE OF RELIANCE (APPLICANT'S EVIDENCE)" submitted herein).

68. The Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

69. The Applicant acknowledges said statement.

70. The Applicant disagrees with said statement in that the name "L'Oreal" and "Oreal" mean the same thing. That is, in the French language L'Oreal means "The Oreal" and "Oreal" remains "Oreal". As such, if one considers this fact then the name "Oreal" is more common (see Applicant "NOTICE OF RELIANCE (APPLICANT'S EVIDENCE)" submitted herein).

71. The Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

72. The Applicant acknowledges said statement.

73. The Applicant acknowledges said statement.

74. The Applicant disagrees with said statement in that the name "Paris" is not only considered to be a geographical reference but a proper name and a surname as well. In this respect any mark containing the word "PARIS" would, in the Attorney's view, always be considered as geographically misdescriptive if not from that local. The Applicant believes this not to be the case.

Opposer's First Set of Interrogatories (1-13)

1. The Opposers' question is irrelevant and immaterial in that it does not deal with the subject matter at hand, namely, whether or not the Applicant's mark is

597 registrable. Superfluous questions regarding trademark origins or genesis are
598 questions non-critical to the outcome of the present case and serve only to cloud
599 the important issues which are truly relevant.

600
601 Applicant maintains that questions important to the outcome of this case can be
602 summed up in the following five points. They are:

- 603
604 (a) the inherent distinctiveness of the trade-names and the extent to which
605 they have become known;
606 (b) the length of time the trade-marks or trade-names have been in use;
607 (c) the nature of the wares, services or business;
608 (d) the nature of the trade; and
609 (e) the degree of resemblance between the trade-marks or trade-names in
610 appearance or sound or in the ideas suggested by them.

611
612 These five questions, the Applicant believes, determine whether the Applicant's
613 mark would be found confusing with the Opposers' marks. Questions unrelated
614 to these fundamental principles are unwarranted and thus need not be answered.

- 615
616 2. The Opposers' question is irrelevant and immaterial in that it does not deal with
617 the subject matter at hand, namely, whether or not the Applicant's mark is
618 registrable. Superfluous questions regarding trademark origins or genesis are
619 questions non-critical to the outcome of the present case and serve only to cloud
620 the important issues which are truly relevant.

621
622 Applicant maintains that questions important to the outcome of this case can be
623 summed up in the following five points. They are:

- 624
625 (a) the inherent distinctiveness of the trade-names and the extent to which
626 they have become known;
627 (b) the length of time the trade-marks or trade-names have been in use;
628 (c) the nature of the wares, services or business;
629 (d) the nature of the trade; and

- (e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.

These five questions, the Applicant believes, determine whether the Applicant's mark would be found confusing with the Opposers' marks. Questions unrelated to these fundamental principles are unwarranted and thus need not be answered.

3. The question is undefined in that the question asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. In regards to the U.S.A. -- the Applicant has not conducted, received nor seen any investigations, surveys, research, polls, focus groups, or opinions concerning confusion or the likelihood of confusion between the Applicant's mark and/or wares and those belonging to the Opposers.
4. The question is undefined in that the question asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. In regards to the U.S.A. -- the Applicant has not conducted, received nor seen any investigations, surveys, research, polls, focus groups, or opinions concerning the availability for use and/or registration of Applicant's mark or variations thereof.
5. The Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce.

In today's business world the capacity to manufacture, distribute and sell does not always rest on a person's actual physical facilities. Such things can be rented, joint ventured or procured via outsourcing. Moreover, licensing is also a practical means of business and just as viable a means of business as creating such companies from scratch. Thus, upon allowance of the Applicant's mark the Applicant will adjudicate and review prevailing market conditions and finally pursue one or more of options stated above as is his right. Thus, by the Applicant's reasoning, the Applicant has shown bona fide intent as the business methods herein stated offer viable options regarding commercial implementation.

Moreover, the Applicant wishes to inquire as to the definition of "bona fide intent" for many successful people have made fortunes in businesses begun from humble beginnings or were contrary to expert opinion. Microsoft, Dell, and Federal Express were all such companies yet against all odds not only prevailed but triumphed. In this same light the Applicant, for example, has successfully filed, prosecuted, and appealed his mark in the U.S.A., and is now currently engaged in these opposition proceedings without the obvious benefits and insight afforded by a seasoned trademark attorney. Thus, is this not a reasonable example of "bona fide intent." for if it is not the Applicant has truly squandered many years foolishly. The Applicant believes that he genuinely possesses "bona fide intent" and will employ this same zeal in his efforts to successfully commercialized his trademark and product once approved.

6. The Applicant's application for the mark "L'OREAL PARIS" was submitted to the USPTO for the United States of America. In this regards there has been no "date of first use" in the U.S.A.. Since the Applicant's mark regards an "intent to use mark" the Applicant believes he has met the letter of the law as the law does not require a "first use" before a trademark application can be made. Questions regarding countries other than the U.S.A. are not within the scope or mandate of these opposition proceedings and thus need not be answered.

7. The type of purchasers that the Applicant intends to market aloe vera drinks includes both male and female encompassing all age groups. The Applicant envisions the product to be a competitor to other beverages such as orange juice, apple juice, lemonade, coffee, tea and other such products.

8. The Applicant intends to market aloe vera drinks primarily to restaurants, clubs and bars and secondarily to grocery stores and other such outlets.

9. In regards to said question -- the Applicant does not know of any such company that markets wares similar to those of the Opposer and also sells aloe vera drinks. In the prosecution of this application even the Examiner could not find any such companies. However, even if such companies could be found it does not set a

precedent for the USPTO trademark roster currently lists many companies utilizing identical marks while selling similar wares without confusion.

10. The Applicant is the only person most familiar with the Applicant's mark, the person most familiar with the Applicant's aloe vera products, the person most familiar with the Applicant's actual or intended advertising, promotion, and marketing of aloe vera drinks in connections with the Applicant's mark, and the person most familiar with the Applicant's actual or intended channels of trade and class of consumers for aloe vera drinks.

However, the Applicant contends that such questions are all irrelevant. That is, the questions are not directed at finding out whether or not the Applicant's mark is confusing with those of the Opposers but rather is directing a gathering extraneous information from the Applicant. Moreover, the questions are also undefined in that the questions asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, they need not be answered.

11. The questions are not directed at finding out whether or not the Applicant's mark is confusing with those of the Opposers but rather is directing a gathering extraneous information from the Applicant. Moreover, the questions are also undefined in that the questions asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, they need not be answered.

12. The questions are not directed at finding out whether or not the Applicant's mark is confusing with those of the Opposers but rather is directing a gathering extraneous information from the Applicant. Moreover, the questions are also undefined in that the questions asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, they need not be answered.

Opposer's First Set of Document Requests (1-24)

1. No such documents exist.

2. No such U.S. documents exist. Second, the request is undefined in that the request asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, non-U.S. references need not be provided.

3. No such documents exist. Second, the request is undefined in that the request asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, non-U.S. references need not be provided.

4. No such documents exist, however, the Applicant is unaware of any current USPTO trademark rules and regulations or legal precedent defining what is and what is not "bona fide intent". As such, the Applicant will restate that he has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce.

Second, the Applicant believes that in today's business world the capacity to manufacture, distribute and sell does not always rest on a person's actual physical facilities. Such things can be rented, joint ventured or procured via outsourcing. Moreover, licensing is also a practical means of business and just as viable a means of business as creating such companies from scratch. Thus, upon allowance of the Applicant's mark the Applicant will adjudicate and review prevailing market conditions and finally pursue one or more of options stated above as is his right. Thus, by the Applicant's reasoning, the Applicant has shown bona fide intent as the business methods herein stated offer viable options regarding commercial implementation.

Third, the request is undefined in that the request asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, non-U.S. references need not be provided.

- 62 5. No such surveys, studies or reports exist.
63
64 6. No such documents exist.
65
66 7. No such documents exist.
67
68 8. No such documents exist.
69
70 9. No such documents exist.
71
72 10. No such documents exist.
73
74 11. No such documents exist. That is, the Applicant does not know of any such
75 company that markets wares similar to those of the Opposers and also sells aloe
76 vera drinks. In the prosecution of this application even the Examiner could not
77 find any such companies. However, even if such companies could be found it
78 does not set a precedent for the USPTO trademark roster currently lists many
79 companies with identical names selling similar wares without confusion.
80
81 12. No such documents exist. Applicant is uncertain as to the date of awareness
82 referred to but it predates the Applicant's filing for the mark "L'OREAL PARIS".
83
84 13. No such U.S. documents exist. Second, the request is undefined in that the
85 request asks for information extraterritorial to the U.S.A. and is thus not within
86 the scope or mandate of these opposition proceedings. As such, non-U.S.
87 references need not be provided.
88
89 14. No such U.S. documents exist. Second, the request is undefined in that the
90 request asks for information extraterritorial to the U.S.A. and is thus not within
91 the scope or mandate of these opposition proceedings. As such, non-U.S.
92 references need not be provided.
93
94 15. No U.S. documents, other than the documents sent to the Applicant by the

795 Opposer regarding the rankings of trademark by Business Week Magazine.
796

797 Second, the request is undefined in that the request asks for information
798 extraterritorial to the U.S.A. and is thus not within the scope or mandate of these
799 opposition proceedings. As such, non-U.S. references need not be provided.
800

- 801 16. Notwithstanding communications to the Applicant from the Opposer, no such
802 documents exist.
803

804 Second, the request is undefined in that the request asks for information
805 extraterritorial to the U.S.A. and is thus not within the scope or mandate of these
806 opposition proceedings. As such, non-U.S. references need not be provided.
807

- 808 17. No such documents exist regarding the U.S.A.
809

810 Second, the request is undefined in that the request asks for information
811 extraterritorial to the U.S.A. and is thus not within the scope or mandate of these
812 opposition proceedings. As such, non-U.S. references need not be provided.
813

- 814 18. This request is not directed at finding out whether or not the Applicant's U.S.
815 trademark application is confusing with the marks of the Opposers but rather is
816 directing a gathering extraneous information from the Applicant not related or
817 relevant to this opposition.
818

819 Second, the request is undefined in that the request asks for information
820 extraterritorial to the U.S.A. and is thus not within the scope or mandate of these
821 opposition proceedings. As such, non-U.S. references need not be provided.
822

- 823 19. This request is not directed at finding out whether or not the Applicant's U.S.
824 trademark application is confusing with the marks of the Opposers but rather is
825 directing a gathering extraneous information from the Applicant not related or
826 relevant to this opposition.
827

28 Second, the request is undefined in that the request asks for information
29 extraterritorial to the U.S.A. and is thus not within the scope or mandate of these
30 opposition proceedings. As such, non-U.S. references need not be provided.
31

- 32 20. This request is not directed at finding out whether or not the Applicant's U.S.
33 trademark application is confusing with the marks of the Opposers but rather is
34 directing a gathering extraneous information from the Applicant not related or
35 relevant to this opposition.
36

37 Second, the request is undefined in that the request asks for information
38 extraterritorial to the U.S.A. and is thus not within the scope or mandate of these
39 opposition proceedings. As such, non-U.S. references need not be provided.
40

- 41 21. No such documents exist.
42

- 43 22. The Applicant will take this opportunity to supply the Opposers with the
44 Applicant's "NOTICE OF RELIANCE (APPLICANT'S EVIDENCE)" as it seems
45 appropriate at this time to do so. This submission should, therefore, be
46 considered the Applicant's serving of his "NOTICE OF RELIANCE (APPLICANT'S
47 EVIDENCE)" to the Opposers' representative as would be customary in such
48 opposition proceedings (more or less). This should provide the Opposers with the
49 evidence with which the Applicant intends to rely on in these opposition
50 proceedings. As is require by current trademark regulations the Applicant will
51 also supply an original copy to the Trademark Trial and Appeal Board.
52

- 53 23. A copy of the file history of trademark Application Serial No. 76/596,736 is easily
54 accessible to the Opposers and their Attorney by logging on to the governments
55 website "www.uspto.gov" entering "trademarks", then entering "View Full Files
56 (TDR)", and finally entering the application serial number above. The Applicant
57 understands the Opposers' Attorney to be a trademark specialist and as such
58 should know of this website and how to download the requested information
59 accordingly. This website will, therefore, provide the Opposers' Attorney with the
60 information he currently seeks without unnecessarily and needless burdening the

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861 Applicant with the downloading, reproduction, and delivery of the information
862 requested.

863
864 24. This request is not directed at finding out whether or not the Applicant's U.S.
865 trademark application is confusing with the marks of the Opposers but rather is
866 directing a gathering extraneous information from the Applicant not related or
867 relevant to this opposition.

868
869 Second, the request is undefined in that the request asks for information
870 extraterritorial to the U.S.A. and is thus not within the scope or mandate of these
871 opposition proceedings. As such, non-U.S. references need not be provided.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/596,736
Published in the Official Gazette on May 6, 2008
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC.,

Opposer,

v.

ROBERT VICTOR MARCON,

Applicant.

Opposition No. 91184456

ORAL ARGUMENT REQUESTED

EXHIBIT D-3 TO OPPOSER'S NOTICE OF RELIANCE

1 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
2 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**
3 **(TRANSMITTAL INFORMATION AND MAILING CERTIFICATION)**
4
5

6 **Opposition No.:** **91184456**
7 **TRADEMARK:** **L'OREAL PARIS**
8 **Application Serial No.:** **76596736**
9 **Applicant(s):** Robert Victor Marcon
10 **Opposer(s):** L'Oreal USA, Inc. and L'Oreal S.A.
11 **Opposer(s) Attorney:** Robert L. Sherman
12 **Reply Number:** Communication - C
13 **Number of Pages:** One hundred and thirty-six (136)
14
15
16
17
18

19 **CERTIFICATE OF SERVICE**
20

21 **Certification:** The undersigned hereby certifies that a true and complete copy of
22 the foregoing correspondence has been served on the Opposers'
23 representative "ROBERT L. SHERMAN" by mailing said copy via
24 the U.S. Postal Service using FIRST CLASS CERTIFIED MAIL,
25 postage prepaid, to "Robert L. Sherman, Paul, Hastings, Janofsky
26 & Walker LLP, 75 East 55th Street, New York, New York, U.S.A.,
27 10022".
28

29 **Certified Mail Serial No.:** **7006 2760 0002 7851 3877**
30 **Date of Deposit:** **7 February 2009**
31

32 Depositor's Signature: Robert Marcon (Robert Marcon)
33
34
35

CASE PARTICULARS

APPLICANT INFORMATION

Name of Applicant: Robert Victor Marcon
Mailing Address: Street: 3471 Sinnicks Avenue
City/Province: Niagara Falls, Ontario
Country: Canada
Zip Code: L2J 2G6
Other Communications: Telephone: (905) 354-2543

OPPOSERS' INFORMATION

First Opposer: L'Oreal USA, Inc.
Mailing Address: 575 Fifth Ave., New York, NY, U.S.A., 10017
Other Communications: Unknown

Second Opposer: L'Oreal S.A.
Mailing Address: L'Oreal S.A., 14 rue Royale, Paris, France, 75008
Other Communications: Unknown

Opposers' Attorney: Robert L. Sherman,
Paul, Hastings, Janofsky & Walker LLP
Mailing Address: Street: 75 East 55th Street
City/State: New York, New York
Country: U.S.A.
Zip Code: 10022
Other Communications: Telephone: (212) 318-6000
e-mail: rls@paulhastings.com

IN THE MATTER OF an Opposition by
L'Oreal USA, Inc. and L'Oreal S.A.
to Application Serial No. 76/596,736 filed by
Robert Victor Marcon
for the trademark "L'OREAL PARIS"
(Opposition No. 91184456)

COMMUNICATION - C
RESPONSE TO OPPOSERS' REQUESTS (SUPPLEMENTARY)

This is a response to the letter mailed January 7, 2009 by the Opposers' representative, namely, Natalie Furman of Paul, Hastings, Janofsky & Walker LLP to the Applicant herein, namely, Robert Victor Marcon. Said letter consists of three (3) requests which include:

- (1) General Discovery Issues;
- (2) Specific Requests for Admissions and Responses;
- (3) Specific Interrogatories and Responses; and
- (4) Specific Document Requests and Responses.

Therefore, in accordance with current trademark protocols and procedures the Applicant will provide the requested information and/or documents to the Opposers' representative as appropriate.

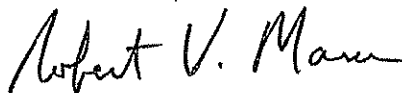
Note also, that the Applicant will respond to each request made by the Opposers' representative in the same sequence and order as was presented in her letter thereby avoiding unnecessary paperwork and duplication (a copy of the Attorney's letter is herein included as reference).

Included also in this communication are the following four (4) items totalling one hundred and thirty-six (136) pages:

Opposition No. 91184456; Mark: L'OREAL PARIS; Appl. No. 76596736; Comm-C

- (1) Applicant's response to the Opposers' "Specific Requests for Admissions and Responses";
- (2) Applicant's response to the Opposers' "Specific Interrogatories and Responses";
- (3) Applicant's response to the Opposers' "Specific Document Requests and Responses";
- (4) Corresponding documents to the above responses as appropriate; and
- (5) A copy of the aforesaid Attorney letter mailed January 7, 2009.

Respectfully submitted,



Robert V. Marcon,
Applicant Pro Se
7 February 2009

Applicant's Supplementary Response To The Opposers'

"Specific Requests for Admissions and Responses"

Initial Matter

The Applicant will confirm the Applicant's use of the term "acknowledges" is to be understood as an "ADMISSION", and that the term "disagrees" is to be understood as a "DENIAL" under Fed. R. Civ. P.36..

Request for Admission No.2

In regards to the Opposers' "L'OREAL" mark -- the Applicant acknowledges said statement. In regards to the Opposers' "L'OREAL PARIS" mark -- the Applicant disagrees with said statement as there are no registered marks or applications utilizing the words "L'OREAL PARIS" that predate the Applicant's filing. In regards to the Opposers' common law "L'OREAL PARIS" mark -- the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

Request for Admission No.4

Applicant acknowledges said statement. That is, the Applicant's mark is identical to the Opposers' claimed "L'OREAL PARIS" common law mark.

Request for Admission No.18

Applicant acknowledges said statement.

Request for Admission No.19

Applicant acknowledges said statement.

Request for Admission No.20

Applicant acknowledges said statement.

Request for Admission No.22

Applicant was aware of the dead "L'OREAL PARIS" marks belonging to the Opposer prior to applying for federal registration of the Applicant's mark. However, in regards to the Opposers' claimed common law marks bearing the words "L'OREAL

Opposition No. 91184456; Mark: L'OREAL PARIS; Appl. No. 76596736; Comm-C

PARIS" the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

Request for Admission No.26

In the Opposers' current letter to the Applicant the Opposers have stated on Page 2 that "the scope of discovery is very broad, generally permitting discovery of all non-privileged information **that is relevant or likely to lead to admissible evidence relating to any claim or defence**".

Furthermore, the Opposers have remarked that "The Board has clearly stated that "[i]t has been generally held that the requirement of relevance must be construed liberally and that discovery should, therefore, be generously allowed **unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding**." *Varian Associates v. Fairfield-Noble Corporation*, 188 U.S.P.Q. 581,583 (T.T.A.B. 1975)(emphasis added).

The Opposers have also declared that the Board has specifically found "[i]nformation concerning a party's selection and adoption of its **involved mark** is generally discoverable (particularly of a defendant)" and that "information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

The Applicant therefore maintains that the Board's intentions are directed to admissions, interrogatories, and documents regarding only the plaintiff's **involved mark** and not to other marks extraneous to that directive. Since the Applicant's other marks do not consist, comprise nor utilize any portion or element of the Opposers' registered, common law or proposed marks the Applicant's other marks are clearly extraneous to these opposition proceedings and so will have no possible bearing upon the issues involved or outcome thereof. Thus, the Applicant contends that said marks are "beyond any doubt" irrelevant and so the request need not be answered.

However, though the Applicant declines to respond to this request, the Applicant will inform the Opposers that any records or documentation regarding the filing, prosecution and/or appeal of the Applicant's other marks are readily available to the Opposers and their Attorney by logging on to the United States Patent and Trademark Office at "www.uspto.gov" and selecting the trademarks section. All trademarks

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belonging to the Applicant can easily be found by entering the Applicant's name therein. Next, all files belonging to each mark sought can be viewed by searching "View Full Files (TDR)" and entering the serial number for the mark desired.

The Applicant presumes that the Opposers' Attorney is fully aware of the information provided therein and how to access it. If the Opposers' Attorney so desires he may, therefore, quickly reference these marks and download and print the information needed without unduly and unnecessarily burdening the Applicant.

Request for Admission No.27

In the Opposers' current letter to the Applicant the Opposers have stated on Page 2 that "the scope of discovery is very broad, generally permitting discovery of all non-privileged information **that is relevant or likely to lead to admissible evidence relating to any claim or defence**".

Furthermore, the Opposers have remarked that "The Board has clearly stated that "[i]t has been generally held that the requirement of relevance must be construed liberally and that discovery should, therefore, be generously allowed **unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding**." Varian Associates v. Fairfield-Noble Corporation, 188 U.S.P.Q. 581,583 (T,T.A.B. 1975)(emphasis added).

The Opposers have also declared that the Board has specifically found "[i]nformation concerning a party's selection and adoption of its **involved mark** is generally discoverable (particularly of a defendant)" and that "information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

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234 However, though the Applicant declines to respond to this request, the Applicant
235 will inform the Opposers that any records or documentation regarding the filing,
236 prosecution and/or appeal of the Applicant's other marks are readily available to the
237 Opposers and their Attorney by logging on to the United States Patent and Trademark
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239 belonging to the Applicant can easily be found by entering the Applicant's name therein.
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241 Files (TDR)" and entering the serial number for the mark desired.

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243 information provided therein and how to access it. If the Opposers' Attorney so desires
244 he may, therefore, quickly reference these marks and download and print the information
245 needed without unduly and unnecessarily burdening the Applicant.

246
247 Request for Admission No.28

248 In the Opposers' current letter to the Applicant the Opposers have stated on Page
249 2 that "the scope of discovery is very broad, generally permitting discovery of all non-
250 privileged information **that is relevant or likely to lead to admissible evidence relating**
251 **to any claim or defence**".

252 Furthermore, the Opposers have remarked that "The Board has clearly stated that
253 "[i]t has been generally held that the requirement of relevance must be construed
254 liberally and that discovery should, therefore, be generously allowed **unless it is clear,**
255 **beyond any doubt, that the information sought can have no possible bearing upon**
256 **the issues involved in the particular proceeding.**" Varian Associates v. Fairfield-Noble
257 Corporation, 188 U.S.P.Q. 581,583 (T,T.A.B. 1975)(emphasis added).

258 The Opposers have also declared that the Board has specifically found
259 "[i]nformation concerning a party's selection and adoption of its **involved mark** is
260 generally discoverable (particularly of a defendant)" and that "information concerning a
261 defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including
262 whether defendant has actual knowledge thereof, and, if so, when and under what
263 circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

264 The Applicant therefore maintains that the Board's intentions are directed to
265 admissions, interrogatories, and documents regarding only the plaintiff's **involved mark**
266 and not to other marks extraneous to that directive. Since the Applicant's other marks

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do not consist, comprise nor utilize any portion or element of the Opposers' registered, common law or proposed marks the Applicant's other marks are clearly extraneous to these opposition proceedings and so will have no possible bearing upon the issues involved or outcome thereof. Thus, the Applicant contends that said marks are "beyond any doubt" irrelevant and so the request need not be answered.

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Request for Admission No.29

In the Opposers' current letter to the Applicant the Opposers have stated on Page 2 that "the scope of discovery is very broad, generally permitting discovery of all non-privileged information **that is relevant or likely to lead to admissible evidence relating to any claim or defence**".

Furthermore, the Opposers have remarked that "The Board has clearly stated that "[i]t has been generally held that the requirement of relevance must be construed liberally and that discovery should, therefore, be generously allowed **unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding.**" Varian Associates v. Fairfield-Noble Corporation, 188 U.S.P.Q. 581,583 (T.T.A.B. 1975)(emphasis added).

The Opposers have also declared that the Board has specifically found "[i]nformation concerning a party's selection and adoption of its **involved mark** is generally discoverable (particularly of a defendant)" and that "information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including

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whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

The Applicant therefore maintains that the Board's intentions are directed to admissions, interrogatories, and documents regarding only the plaintiff's **involved mark** and not to other marks extraneous to that directive. Since the Applicant's other marks do not consist, comprise nor utilize any portion or element of the Opposers' registered, common law or proposed marks the Applicant's other marks are clearly extraneous to these opposition proceedings and so will have no possible bearing upon the issues involved or outcome thereof. Thus, the Applicant contends that said marks are "beyond any doubt" irrelevant and so the request need not be answered.

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Request for Admission No.30

In the Opposers' current letter to the Applicant the Opposers have stated on Page 2 that "the scope of discovery is very broad, generally permitting discovery of all non-privileged information **that is relevant or likely to lead to admissible evidence relating to any claim or defence**".

Furthermore, the Opposers have remarked that "The Board has clearly stated that "[i]t has been generally held that the requirement of relevance must be construed liberally and that discovery should, therefore, be generously allowed **unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon**

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the issues involved in the particular proceeding." Varian Associates v. Fairfield-Noble Corporation, 188 U.S.P.Q. 581,583 (T.T.A.B. 1975)(emphasis added).

The Opposers have also declared that the Board has specifically found "[i]nformation concerning a party's selection and adoption of its **involved mark** is generally discoverable (particularly of a defendant)" and that "information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

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The Applicant presumes that the Opposers' Attorney is fully aware of the information provided therein and how to access it. If the Opposers' Attorney so desires he may, therefore, quickly reference these marks and download and print the information needed without unduly and unnecessarily burdening the Applicant.

Request for Admission No.31

In the Opposers' current letter to the Applicant the Opposers have stated on Page 2 that "the scope of discovery is very broad, generally permitting discovery of all non-privileged information **that is relevant or likely to lead to admissible evidence relating**

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to any claim or defence".

Furthermore, the Opposers have remarked that "The Board has clearly stated that "[i]t has been generally held that the requirement of relevance must be construed liberally and that discovery should, therefore, be generously allowed **unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding.**" *Varian Associates v. Fairfield-Noble Corporation*, 188 U.S.P.Q. 581,583 (T.T.A.B. 1975)(emphasis added).

The Opposers have also declared that the Board has specifically found "[i]nformation concerning a party's selection and adoption of its **involved mark** is generally discoverable (particularly of a defendant)" and that "information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

The Applicant therefore maintains that the Board's intentions are directed to admissions, interrogatories, and documents regarding only the plaintiff's **involved mark** and not to other marks extraneous to that directive. Since the Applicant's other marks do not consist, comprise nor utilize any portion or element of the Opposers' registered, common law or proposed marks the Applicant's other marks are clearly extraneous to these opposition proceedings and so will have no possible bearing upon the issues involved or outcome thereof. Thus, the Applicant contends that said marks are "beyond any doubt" irrelevant and so the request need not be answered.

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399 Request for Admission No.32

400 In the Opposers' current letter to the Applicant the Opposers have stated on Page
401 2 that "the scope of discovery is very broad, generally permitting discovery of all non-
402 privileged information **that is relevant or likely to lead to admissible evidence relating**
403 **to any claim or defence**".

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409 Corporation, 188 U.S.P.Q. 581,583 (T.T.A.B. 1975)(emphasis added).

410 The Opposers have also declared that the Board has specifically found
411 "[i]nformation concerning a party's selection and adoption of its **involved mark** is
412 generally discoverable (particularly of a defendant)" and that "information concerning a
413 defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including
414 whether defendant has actual knowledge thereof, and, if so, when and under what
415 circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

416 The Applicant therefore maintains that the Board's intentions are directed to
417 admissions, interrogatories, and documents regarding only the plaintiff's **involved mark**
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419 do not consist, comprise nor utilize any portion or element of the Opposers' registered,
420 common law or proposed marks the Applicant's other marks are clearly extraneous to
421 these opposition proceedings and so will have no possible bearing upon the issues
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Request for Admission No.33

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The Applicant therefore maintains that the Board's intentions are directed to admissions, interrogatories, and documents regarding only the plaintiff's **involved mark** and not to other marks extraneous to that directive. Since the Applicant's other marks do not consist, comprise nor utilize any portion or element of the Opposers' registered, common law or proposed marks the Applicant's other marks are clearly extraneous to these opposition proceedings and so will have no possible bearing upon the issues involved or outcome thereof. Thus, the Applicant contends that said marks are "beyond any doubt" irrelevant and so the request need not be answered.

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Request for Admission No.34

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Request for Admission No.35

In the Opposers' current letter to the Applicant the Opposers have stated on Page 2 that "the scope of discovery is very broad, generally permitting discovery of all non-privileged information **that is relevant or likely to lead to admissible evidence relating to any claim or defence**".

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532 admissions, interrogatories, and documents regarding only the plaintiff's **involved mark**
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548 information provided therein and how to access it. If the Opposers' Attorney so desires
549 he may, therefore, quickly reference these marks and download and print the information
550 needed without unduly and unnecessarily burdening the Applicant.

551
552 Request for Admission No.36

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554 2 that "the scope of discovery is very broad, generally permitting discovery of all non-
555 privileged information **that is relevant or likely to lead to admissible evidence relating**
556 **to any claim or defence**".

557 Furthermore, the Opposers have remarked that "The Board has clearly stated that
558 "[i]t has been generally held that the requirement of relevance must be construed
559 liberally and that discovery should, therefore, be generously allowed **unless it is clear,**
560 **beyond any doubt, that the information sought can have no possible bearing upon**
561 **the issues involved in the particular proceeding.**" Varian Associates v. Fairfield-Noble
562 Corporation, 188 U.S.P.Q. 581,583 (T,T.A.B. 1975)(emphasis added).

563 The Opposers have also declared that the Board has specifically found

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"[i]nformation concerning a party's selection and adoption of its **involved mark** is generally discoverable (particularly of a defendant)" and that "information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

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The Applicant presumes that the Opposers' Attorney is fully aware of the information provided therein and how to access it. If the Opposers' Attorney so desires he may, therefore, quickly reference these marks and download and print the information needed without unduly and unnecessarily burdening the Applicant.

Request for Admission No.37

The Applicant disagrees with said statement. That is, the Applicant has always had a bona fide intent to use said marks.

Request for Admission No.39

The Applicant disagrees with the Opposers. That is, the Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce and not to make

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a philosophical point about trademark protection.

Request for Admission No.41

The Applicant disagrees with said statement. That is the Applicant did not believe that at the time of filing the Opposers' "L'OREAL" mark would be confusing with the Applicant's mark. In regards to the Opposers' dead "L'OREAL PARIS" marks -- the Applicant did not believe that at the time of filing there would be confusion with the Applicant's mark. In regards to the Opposers' common law rights in the "L'OREAL PARIS" mark -- the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

Request for Admission No.43

The Applicant disagrees with said statement. That is the Applicant did not believe that at the time of filing the Opposers' "L'OREAL" mark would be confusion with the Applicant's mark. In regards to the Opposers' dead "L'OREAL PARIS" marks -- the Applicant did not believe that at the time of filing there would be confusion with the Applicant's mark. In regards to the Opposers' common law rights in the "L'OREAL PARIS" mark -- the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

Request for Admission No.46

The Applicant disagrees with said statement. That is, the Applicant does not lack the capacity to manufacture or sell aloe vera drinks.

Request for Admission No.47

The Applicant disagrees with said statement.

Request for Admission No.48

The Applicant disagrees with said statement.

Request for Admission No.50

The Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

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Request for Admission No.51

Applicant acknowledges the Opposers' statement as it regards the Opposers' "L'OREAL" marks. In regards to the Opposers' "L'OREAL PARIS" common law rights -- the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

Request for Admission No.62

Applicant acknowledges said statement.

**Applicant's Supplementary Response To The Opposers'
"Specific Interrogatories and Responses"**

Interrogatory No.1

The Applicant selected the mark "L'OREAL PARIS" because it has bilingual qualities and was not registered, at the time of filing, for the wares the Applicant submitted. Second, the Applicant did not consider any other variation of the "L'OREAL PARIS" mark that he filed. Third, the Applicant was the person most knowledgeable in the selection of the mark and goods therein. Fourth, the date of selection was approximately one month before filing the application in Canada or around mid November 2003.

Interrogatory No.2

The Applicant is unaware of the exact time that he became aware of the "L'OREAL" (registered) and the "L'OREAL PARIS" (abandoned) marks but it does predate the filing of the Applicant's application.

In regards to the Opposers' "L'OREAL PARIS" common law rights -- the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

The Applicant is also the person most knowledgeable with the foregoing.

663 Interrogatory No.3

664 There are none except for the documents that the Opposers have themselves
665 submitted to the Canadian Intellectual Property Office (Opposition Board) during current
666 opposition proceedings regarding the "APPROVAL" of the Applicant's Canadian
667 application for the mark "L'OREAL PARIS" (Serial No. 1,201,383). These documents are
668 therefore already in the Opposers' possession as they are the originators of said
669 documents.

670
671 Interrogatory No.4

672 There are none except for the documents that the Opposers have themselves
673 submitted to the Canadian Intellectual Property Office (Opposition Board) during current
674 opposition proceedings regarding the "APPROVAL" of the Applicant's Canadian
675 application for the mark "L'OREAL PARIS" (Serial No. 1,201,383). These documents are
676 therefore already in the Opposers' possession as they are the originators of said
677 documents.

678
679 Interrogatory No.5

680 The Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS"
681 in commerce and will begin to do so once his mark is approved. Although the Applicant
682 has not formalized any business plans nor produced or sold any wares the Applicant
683 contends that he is not required to do so until his mark has been approved. The
684 Applicant has, however, searched the internet for manufactures of aloe vera drinks and
685 has found various companies that offer such products. Though no printouts or
686 documents were kept such companies include Aloe Farms Inc., Genereux Ltd., Psb Co
687 Ltd, and Tobe Inc. The Applicant also believes that there are many other companies like
688 these in the marketplace. Thus, the Applicant will, once his mark is approved, begin by
689 first approaching these companies to outsource the manufacture of his aloe vera drinks.
690 Once a supply source is secured the Applicant will then approach various nearby clubs,
691 bars, and restaurants to test market sales and streamline logistics.

692 Moreover, and as previously stated, the capacity to manage, manufacture,
693 distribute and sell in today's business world does not always rest on a persons actual
694 personal abilities or physical facilities. Such things can be hired, joint ventured or
695 procured via outsourcing. Licensing is also a practical means of business and just as

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696 viable a means of business as creating such companies from scratch. Thus, upon
697 allowance of the Applicant's mark the Applicant will begin as previously mentioned and
698 then adjudicate and review prevailing market conditions and finally pursue one or more
699 of the options expressed above as is his right. Ergo, by the Applicant's reasoning, the
700 Applicant has shown bona fide intent as the business methods herein stated offer viable
701 options regarding commercial implementation.

702
703 Interrogatory No.9

704 Basically, the only third parties to which the Applicant is aware are those
705 mentioned in the documents that the Opposers have themselves submitted to the
706 Canadian Intellectual Property Office (Opposition Board) during current opposition
707 proceedings regarding the "APPROVAL" of the Applicant's Canadian application for the
708 mark "L'OREAL PARIS" (Serial No. 1,201,383). These documents are therefore already in
709 the Opposers' possession as they are the originators of said documents.

710
711 Interrogatory No.11

712 There are none at this time.

713
714 Interrogatory No.12

715 There are none at this time.

716
717 Interrogatory No.13

718 There are none.

719
720
721
722
723
724 **Applicant's Supplementary Response To The Opposers'**

725 **"Specific Document Requests and Responses"**

726
727 Document Request No.1

728 In regards to the prior answer given by the Applicant the Applicant will further

Opposition No. 91184456; Mark: L'OREAL PARIS; Appl. No. 76596736; Comm-C

clarify said answer as follows: "The Applicant has provided all necessary documents in accordance with the answers so given by the Applicant."

Document Request No.2

No such documents exist.

Document Request No.3

No such documents exist.

Document Request No.4

The information previously stated is all that is. Hard copies do not exist.

Document Request No.11

There are none except for the documents that the Opposers have themselves submitted to the Canadian Intellectual Property Office (Opposition Board) during current opposition proceedings regarding the "APPROVAL" of the Applicant's Canadian application for the mark "L'OREAL PARIS" (Serial No. 1,201,383). These documents are therefore already in the Opposers' possession as they are the originators of said documents. The Applicant therefore believes that he is not required to duplicate and provide said documents to the Opposers since the Opposers themselves are the originators of said documents and therefore have all of said documents already in their possession.

Document Request No.13

There are none except for the documents that the Opposers have themselves submitted to the Canadian Intellectual Property Office (Opposition Board) during current opposition proceedings regarding the "APPROVAL" of the Applicant's Canadian application for the mark "L'OREAL PARIS" (Serial No. 1,201,383). These documents are therefore already in the Opposers' possession as they are the originators of said documents. The Applicant therefore believes that he is not required to duplicate and provide said documents to the Opposers since the Opposers themselves are the originators of said documents and therefore have all of said documents already in their possession.

Opposition No. 91184456; Mark: L'OREAL PARIS; Appl. No. 76596736; Comm-C

762 Document Request No.14

763 There are none except for the documents that the Opposers have themselves
764 submitted to the Canadian Intellectual Property Office (Opposition Board) during current
765 opposition proceedings regarding the "APPROVAL" of the Applicant's Canadian
766 application for the mark "L'OREAL PARIS" (Serial No. 1,201,383). These documents are
767 therefore already in the Opposers' possession as they are the originators of said
768 documents. The Applicant therefore believes that he is not required to duplicate and
769 provide said documents to the Opposers since the Opposers themselves are the
770 originators of said documents and therefore have all of said documents already in their
771 possession.

772
773 Document Request No.15

774 There are none except for the documents that the Opposers have themselves
775 submitted to the Canadian Intellectual Property Office (Opposition Board) during current
776 opposition proceedings regarding the "APPROVAL" of the Applicant's Canadian
777 application for the mark "L'OREAL PARIS" (Serial No. 1,201,383). These documents are
778 therefore already in the Opposers' possession as they are the originators of said
779 documents. The Applicant therefore believes that he is not required to duplicate and
780 provide said documents to the Opposers since the Opposers themselves are the
781 originators of said documents and therefore have all of said documents already in their
782 possession.

783
784 Document Request No.16

785 No such documents exist other than those relating to the Applicant's trademark
786 application in Canada (Serial No. 1,201,383) and the Applicant's corresponding
787 trademark application in the United States (Serial No. 76/596,736). The Canadian
788 documents regarding the filing and prosecution of the Applicant's mark are herein
789 enclosed. Documents regarding the Opposers' Canadian opposition to the Applicant's
790 mark are already in the Opposers' possession as they are the originators of said
791 documents. As for the documents regarding the Applicant's U.S. application these
792 documents are public property and are readily available and downloadable from the
793 United States Patent and Trademark Office (uspto.gov) respectively. This website will
794 allow the Opposers easy access to all of the desired documents as the case may be. The

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Applicant presumes that the Opposers' Attorney is familiar with this procedure.

Document Request No.17

No such documents exist other than those relating to the Applicant's trademark application in Canada (Serial No. 1,201,383) and the Applicant's corresponding trademark application in the United States (Serial No. 76/596,736). The Canadian documents regarding the filing and prosecution of the Applicant's mark are herein enclosed. Documents regarding the Opposers' Canadian opposition to the Applicant's mark are already in the Opposers' possession as they are the originators of said documents. As for the documents regarding the Applicant's U.S. application these documents are public property and are readily available and downloadable from the United States Patent and Trademark Office (uspto.gov) respectively. This website will allow the Opposers easy access to all of the desired documents as the case may be. The Applicant presumes that the Opposers' Attorney is familiar with this procedure.

Document Request No.18

Documents relating to said names and marks are already in the possession of the Opposers as said documents form part of the Opposers' evidence submitted to the Canadian Intellectual Property Office (Opposition Board). In any event said other marks are readily available at both the Canadian Intellectual Property Office (CIPO) and the United States Patent and Trademark Office websites respectively as the Applicant has only ever applied for a trademark in Canada and the United States.

In addition, the Opposers' current letter to the Applicant the Opposers have stated on Page 2 that "the scope of discovery is very broad, generally permitting discovery of all non-privileged information **that is relevant or likely to lead to admissible evidence relating to any claim or defence**".

Furthermore, the Opposers have remarked that "The Board has clearly stated that "[i]t has been generally held that the requirement of relevance must be construed liberally and that discovery should, therefore, be generously allowed **unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding**." *Varian Associates v. Fairfield-Noble Corporation*, 188 U.S.P.Q. 581,583 (T.T.A.B. 1975)(emphasis added).

The Opposers have also declared that the Board has specifically found

828 "[i]nformation concerning a party's selection and adoption of its **involved mark** is
829 generally discoverable (particularly of a defendant)" and that "information concerning a
830 defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including
831 whether defendant has actual knowledge thereof, and, if so, when and under what
832 circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

833 The Applicant therefore maintains that the Board's intentions are directed to
834 admissions, interrogatories, and documents regarding only the plaintiff's **involved mark**
835 and not to other marks extraneous to that directive. Since the Applicant's other marks
836 do not consist, comprise nor utilize any portion or element of the Opposers' registered,
837 common law or proposed marks the Applicant's other marks are clearly extraneous to
838 these opposition proceedings and so will have no possible bearing upon the issues
839 involved or outcome thereof. Thus, the Applicant contends that said marks are "beyond
840 any doubt" irrelevant and so the request need not be answered.

841 However, though the Applicant declines to respond to this request, the Applicant
842 will inform the Opposers that any records or documentation regarding the filing,
843 prosecution and/or appeal of the Applicant's other marks are readily available to the
844 Opposers and their Attorney by logging on to the United States Patent and Trademark
845 Office at "www.uspto.gov" and selecting the trademarks section. All trademarks
846 belonging to the Applicant can easily be found by entering the Applicant's name therein.
847 Next, all files belonging to each mark sought can be viewed by searching "View Full
848 Files (TDR)" and entering the serial number for the mark desired.

849 The Applicant presumes that the Opposers' Attorney is fully aware of the
850 information provided therein and how to access it. If the Opposers' Attorney so desires
851 he may, therefore, quickly reference these marks and download and print the information
852 needed without unduly and unnecessarily burdening the Applicant.

853
854 Document Request No.19

855 No such documents exist.

856
857 Document Request No.20

858 No such documents exist.

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Document Request No.24

The Canadian documents regarding the filing and prosecution of the Applicant's mark (Serial No. 1,201,383) are herein enclosed. The documents regarding the Opposers' Canadian opposition to the Applicant's mark are already in the Opposers' possession as they are the originators of said opposition. The Applicant therefore believes that he is not required to duplicate and provide said documents to the Opposers since the Opposers themselves are the originators of said documents and therefore already have all of said documents in their possession.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/596,736
Published in the Official Gazette on May 6, 2008
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC.,

Opposer,

v.

ROBERT VICTOR MARCON,

Applicant.

Opposition No. 91184456

ORAL ARGUMENT REQUESTED

EXHIBIT D-4 TO OPPOSER'S NOTICE OF RELIANCE

1 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
2 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**
3 **(TRANSMITTAL INFORMATION AND MAILING CERTIFICATION)**
4
5

6 **Opposition No.:** 91184456
7 **TRADEMARK:** L'OREAL PARIS
8 **Application Serial No.:** 76/596,736
9 **Applicant(s):** Robert Victor Marcon
10 **Opposer(s):** L'Oreal USA, Inc. and L'Oreal S.A.
11 **Opposer(s) Attorney:** Robert L. Sherman
12 **Reply Number:** Communication - D
13 **Number of Pages:** Fifteen (15)
14
15
16
17
18

19 **CERTIFICATE OF SERVICE**

20
21 **Certification:** The undersigned hereby certifies that a true and complete copy of
22 the foregoing correspondence has been served on the Opposers'
23 representative "ROBERT L. SHERMAN" by mailing said copy via the
24 U.S. Postal Service using FIRST CLASS CERTIFIED MAIL, postage
25 prepaid, to "Robert L. Sherman, Paul, Hastings, Janofsky & Walker
26 LLP, 75 East 55th Street, New York, New York, U.S.A., 10022".
27

28 **Certified Mail Serial No.: 7003 1680 0001 7602 8153**

29 **Date of Deposit:** 9 March 2009
30

31 *Robert Marcon*
32 **Depositor's Signature:** _____ (Robert Marcon)
33
34
35

CASE PARTICULARS

APPLICANT INFORMATION

Name of Applicant: Robert Victor Marcon
Mailing Address: Street: 3471 Sinnicks Avenue
City/Province: Niagara Falls, Ontario
Country: Canada
Zip Code: L2J 2G6
Other Communications: Telephone: (905) 354-2543

OPPOSERS' INFORMATION

First Opposer: L'Oreal USA, Inc.
Mailing Address: 575 Fifth Ave., New York, NY, U.S.A., 10017
Other Communications: Unknown
Second Opposer: L'Oreal S.A.
Mailing Address: L'Oreal S.A., 14 rue Royale, Paris, France, 75008
Other Communications: Unknown

Opposers' Attorney: Robert L. Sherman,
Paul, Hastings, Janofsky & Walker LLP
Mailing Address: Street: 75 East 55th Street
City/State: New York, New York
Country: U.S.A.
Zip Code: 10022
Other Communications: Telephone: (212) 318-6000
e-mail: rls@paulhastings.com

IN THE MATTER OF an Opposition by
L'Oreal USA, Inc. and L'Oreal S.A.
to Application Serial No. 76/596,736 filed by
Robert Victor Marcon
for the trademark "L'OREAL PARIS"
(Opposition No. 91184456)

COMMUNICATION - D
RESPONSE TO OPPOSERS' REQUESTS (SUPPLEMENTARY)

This is a response to the letter mailed February 27, 2009 by the Opposers' representative, namely, Natalie Furman of Paul, Hastings, Janofsky & Walker LLP to the Applicant herein, namely, Robert Victor Marcon. Said letter regards the Applicant's Responses to Opposers' Deficiency Letter and Supplemental Responses to Opposer's Discovery Requests. The Opposers claim that a number of responses remain deficient and therefore request that said deficiencies be answered or supplemented accordingly.

Therefore, in accordance with current trademark protocols and procedures the Applicant will provide the requested information and/or documents to the Opposers' representative as appropriate.

Note also, that the Applicant will respond to each request made by the Opposers' representative in the same sequence and order as was presented in her letter thereby avoiding unnecessary paperwork and duplication (a copy of the Attorney's letter is herein included as reference).

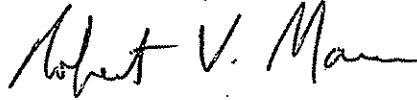
Included in this communication are the following three (3) items totalling one sixteen (16) pages:

- (1) Applicant's supplementary response to the Opposers' "Specific Requests for Admissions and Responses";

Opposition No. 91184456; Mark: L'OREAL PARIS; Appl. No. 76/596,736; Comm-D

- (2) Applicant's supplementary response to the Opposers' "Specific Document Requests and Responses"; and
- (3) A copy of the aforesaid Attorney letter mailed February 27, 2009.

Cordially,



Robert V. Marcon,
Applicant Pro Se
9 March 2009

Applicant's Supplementary Response To The Opposers'
"Specific Requests for Admissions and Responses"

Request for Admission No.22

Applicant was aware of the dead "L'OREAL PARIS" marks belonging to the Opposer prior to applying for federal registration of the Applicant's mark. However, in regards to the Opposers' claimed common law marks bearing the words "L'OREAL PARIS" the Applicant was not aware of the Opposer's use of its "L'OREAL PARIS" mark.

Request for Admission No.26

Although the Applicant still maintains that the question is irrelevant and immaterial to these opposition proceedings the Applicant will answer the request for admission. As such, the Applicant admits to having filed for other U.S. trademark applications that are identical to previously registered marks.

Request for Admission No.27

Although the Applicant still maintains that the question is irrelevant and immaterial to these opposition proceedings the Applicant will answer the request for admission. As such, the Applicant acknowledges the Opposers' statement.

Request for Admission No.28

Although the Applicant still maintains that the question is irrelevant and immaterial to these opposition proceedings the Applicant will answer the request for admission. As such, the Applicant acknowledges Opposers' statement in regards to flavored milk and milk-based beverages, water, chocolates, candies, ice-cream bars and bottled water but not infant formula or dietary supplements.

Request for Admission No.29

Although the Applicant still maintains that the question is irrelevant and

Opposition No. 91184456; Mark: L'OREAL PARIS; Appl. No. 76/596,736; Comm-D

168 immaterial to these opposition proceedings the Applicant will answer the request for
169 admission. As such, the Applicant acknowledges the Opposers' statement.

170
171
172 Request for Admission No.30

173 Although the Applicant still maintains that the question is irrelevant and
174 immaterial to these opposition proceedings the Applicant will answer the request for
175 admission. As such, the Applicant acknowledges the Opposers' statement.

176
177
178 Request for Admission No.31

179 Although the Applicant still maintains that the question is irrelevant and
180 immaterial to these opposition proceedings the Applicant will answer the request for
181 admission. As such, the Applicant acknowledges the Opposers' statement.

182
183
184 Request for Admission No.32

185 Although the Applicant still maintains that the question is irrelevant and
186 immaterial to these opposition proceedings the Applicant will answer the request for
187 admission. As such, the Applicant acknowledges Opposers' statement in regards to
188 natural mineral water only and not the others.

189
190
191 Request for Admission No.33

192 Although the Applicant still maintains that the question is irrelevant and
193 immaterial to these opposition proceedings the Applicant will answer the request for
194 admission. As such, the Applicant acknowledges the Opposers' statement.

195
196
197 Request for Admission No.34

198 Although the Applicant still maintains that the question is irrelevant and
199 immaterial to these opposition proceedings the Applicant will answer the request for
200 admission.

Opposition No. 91184456; Mark: L'OREAL PARIS; Appl. No. 76/596,736; Comm-D

201 Applicant disagrees with the Opposers' statement. That is, the Applicant was
202 aware of the prior registrations, both live and dead, of the referred to trademarks.
203 However, as regards the extent of their fame and general public recognition the
204 Applicant is without knowledge sufficient to form a belief as to or gauge the scope of
205 said fame and general public recognition. Consequently, the Applicant cannot give a
206 definitive admission in this regards.

207
208
209 Request for Admission No.35

210 Although the Applicant still maintains that the question is irrelevant and
211 immaterial to these opposition proceedings the Applicant will answer the request for
212 admission.

213 Applicant disagrees with said statement.
214
215

216 Request for Admission No.36

217 Although the Applicant still maintains that the question is irrelevant and
218 immaterial to these opposition proceedings the Applicant will answer the request for
219 admission.

220 Applicant disagrees with said statement.
221
222

223 Request for Admission No.41

224 The Applicant disagrees with said statement. That is the Applicant did not
225 believe that at the time of filing the Opposers' "L'OREAL" mark would be confusing with
226 the Applicant's mark.

227 In regards to the Opposers' dead "L'OREAL PARIS" marks -- the Applicant did not
228 believe that at the time of filing there would be confusion with the Applicant's mark.

229 In regards to the Opposers' common law rights in the "L'OREAL PARIS" mark -- the
230 Applicant did not believe that at the time of filing there would be confusion with the
231 Applicant's mark simply because the Applicant did not know then nor does he know
232 now what "common law rights" are.
233

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Request for Admission No.43

The Applicant disagrees with said statement. That is the Applicant did not believe that at the time of filing the Opposers' "L'OREAL" mark would be confusion with the Applicant's mark.

In regards to the Opposers' dead "L'OREAL PARIS" marks -- the Applicant did not believe that at the time of filing there would be confusion with the Applicant's mark.

In regards to the Opposers' common law rights in the "L'OREAL PARIS" mark -- the Applicant did not believe that at the time of filing there would be confusion with the Applicant's mark simply because the Applicant did not know then nor does he know now what "common law rights" are.

Request for Admission No.51

Applicant acknowledges the Opposers' statement as it regards the Opposers' "L'OREAL" marks.

In regards to the Opposers' common law rights in the "L'OREAL PARIS" mark -- the Applicant did not believe that at the time of filing there would be confusion with the Applicant's mark simply because the Applicant did not know then nor does he know now what "common law rights" are.

Applicant's Supplementary Response To The Opposers'

"Specific Document Requests and Responses"

Document Request No.16

The Applicant consents to the Opposers' proposal and so will sign the enclosed document entitled "STIPULATION REGARDING AUTHENTICITY AND ADMISSIBILITY OF PAGES PRINTED FROM THE USPTO WEB SITE". This should therefore satisfy the Opposer document request.

Take note that the Applicant has signed three (3) copies. Please sign and return

Opposition No. 91184456; Mark: L'OREAL PARIS; Appl. No. 76/596,736; Comm-D

one (1) copy to the Applicant for his files.

Document Request No.17

The Applicant consents to the Opposers' proposal and so will sign the enclosed document entitled "STIPULATION REGARDING AUTHENTICITY AND ADMISSIBILITY OF PAGES PRINTED FROM THE USPTO WEB SITE". This should therefore satisfy the Opposer document request.

Take note that the Applicant has signed three (3) copies. Please sign and return one (1) copy to the Applicant for his files.

Document Request No.18

The Applicant consents to the Opposers' proposal and so will sign the enclosed document entitled "STIPULATION REGARDING AUTHENTICITY AND ADMISSIBILITY OF PAGES PRINTED FROM THE USPTO WEB SITE". This should therefore satisfy the Opposer document request.

Take note that the Applicant has signed three (3) copies. Please sign and return one (1) copy to the Applicant for his files.